Deutscher Bundestag **Drucksache 17/5242**

17. Wahlperiode 23. 03. 2011

Beschlussempfehlung und Bericht

des Rechtsausschusses (6. Ausschuss)

zu der Unterrichtung
– Drucksache 17/4768 Nr. A.4 –

Bericht der Kommission an den Rat, das Europäische Parlament, den Europäischen Wirtschafts- und Sozialausschuss und den Ausschuss der Regionen Anwendung der Richtlinie 2004/48/EG des Europäischen Parlaments und des Rates vom 29. April 2004 zur Durchsetzung der Rechte des geistigen Eigentums (inkl. 5140/11 ADD 1) (ADD 1 in Englisch)
KOM(2010) 779 endg.; Ratsdok. 5140/11

hier: Stellungnahme im Rahmen eines Konsultationsverfahrens der Europäischen Kommission

A. Problem

Die Europäische Kommission hat am 22. Dezember 2010 einen Bericht zur „Anwendung der Richtlinie 2004/48/EG des Europäischen Parlaments und des Rates vom 29. April 2004 zur Durchsetzung der Rechte des geistigen Eigentums" vorgelegt. Dem Bericht zufolge ist die Richtlinie nicht mit Blick auf die Herausforderungen konzipiert worden, die das Internet für die Durchsetzung der Rechte des geistigen Eigentums mit sich bringt. Der Bericht wirft im Wesentlichen die Frage auf, ob vor diesem Hintergrund unter anderem der Einsatz einstweiliger Maßnahmen und Sicherungsmaßnahmen wie gerichtliche Anordnungen, Verfahren zur Sammlung und Sicherung von Beweismitteln, die Präzisierung der Bedeutung der verschiedenen Abhilfemaßnahmen sowie die Berechnung von Schadensersatz besonderer Aufmerksamkeit bedürfen. Die Kommission hat allen interessierten Akteuren Gelegenheit zur Stellungnahme zu dem Bericht bis zum 31. März 2011 gegeben.

B. Lösung

Kenntnisnahme des Berichts der Kommission und Annahme einer Entschließung, mit der der Deutsche Bundestag zu dem Bericht Stellung nimmt und seinen Präsidenten bittet, den Beschluss als Beitrag des Deutschen Bundestages zum Konsultationsverfahren an den Präsidenten der Europäischen Kommission zu übermitteln.

Annahme einer Entschließung mit den Stimmen der Fraktionen der CDU/CSU, SPD und FDP gegen die Stimmen der Fraktion BÜNDNIS 90/DIE GRÜNEN bei Stimmenthaltung der Fraktion DIE LINKE. unter Kenntnisnahme des Berichts der Europäischen Kommission.

C. Alternativen

Keine.

D. Kosten

Wurden im Ausschuss nicht erörtert.

Beschlussempfehlung

Der Bundestag wolle beschließen,

in Kenntnis der Unterrichtung auf Drucksache 17/4768 Nr. A.4 folgende Entschließung anzunehmen:

„I. Der Deutsche Bundestag nimmt zu dem „Bericht der Kommission an den Rat, das Europäische Parlament, den Europäischen Wirtschafts- und Sozialausschuss und den Ausschuss der Regionen – Anwendung der Richtlinie 2004/48/EG des Europäischen Parlaments und des Rates vom 29. April 2004 zur Durchsetzung der Rechte des geistigen Eigentums“ wie folgt Stellung und bittet seinen Präsidenten, den Beschluss als Beitrag des Deutschen Bundestages zum Konsultationsverfahren an den Präsidenten der Europäischen Kommission zu übermitteln:

II. Der Deutsche Bundestag stellt fest:

1. Der effektive Schutz und die wirksame Durchsetzung der Rechte des geistigen Eigentums sind eine unerlässliche Voraussetzung, um Kreativität und Innovationen zu fördern. Kreative Ideen und Innovationen bedürfen von ihrer Entstehung bis hin zu ihrer Verwirklichung eines hohen Maßes an immateriellem und materiellem Einsatz. Der Staat muss daher den rechtlichen Rahmen dafür schaffen, dass Kreativität und die dafür aufgewendeten Mittel auch eine Chance darauf haben, sich auszuzahlen. Deutschland verfügt nur über geringe Rohstoffkapazitäten, so dass wir ein besonderes Interesse am Schutz des geistigen Eigentums haben. Kreative Innovationen und Ideen waren schon immer ein Eckpfeiler unserer Wirtschaft. Der Deutsche Bundestag teilt daher das Ziel der Kommission, die Rechte des Geistigen Eigentums besser durchzusetzen und damit kreatives Schaffen und Innovationen zu fördern.

2. Dies gilt insbesondere im Internet, wo neue Ideen einerseits besonders schnell und weit verbreitet werden, andererseits aber auch in besonderer Weise dem Zugriff anderer ausgesetzt sind. Das Internet erleichtert die Verletzung von Rechten des geistigen Eigentums. So lassen sich im Internet leicht urheberrechtlich geschützte Dateien unter den Nutzern austauschen, ohne den Rechteinhabern dafür einen angemessenen Ausgleich zukommen zu lassen. Aber auch auf die reale Welt hat das Internet Auswirkungen, wenn zum Beispiel körperliche Waren, die geistige Eigentumsrechte verletzen, im Internet zum Kauf angeboten werden.

3. Es muss durch Aufklärungskampagnen, Öffentlichkeitsarbeit und Medienerziehung kontinuierlich und konsequent daran gearbeitet werden, das Bewusstsein für den Wert geistigen Eigentums zu schärfen. Die Menschen sind bereit, für attraktive und legale Inhalte im Netz zu bezahlen. Diese Bereitschaft muss von der Wirtschaft durch neue Geschäftsmodelle gestärkt werden.

III. Der Deutsche Bundestag nimmt zu den Punkten, in denen die Kommission Änderungsbedarf prüfen will, wie folgt Stellung:

1. Der Deutsche Bundestag betont, dass mögliche künftige Regelungen zur Bekämpfung von Rechtsverletzungen im Internet unter Berücksichtigung aller beteiligten Interessengruppen erfolgen müssen. Dabei sind die Interessen der Rechteinhaber an ihren geistigen Eigentumsrechten mit denen der Diensteanbieter (Host-Provider) an der Ausübung ihres Wirtschaftsbetriebes und dem Recht der Nutzer auf Schutz ihrer Privatsphäre in einen angemessenen Ausgleich zu bringen. Der Deutsche Bundestag begrüßt dabei insbesondere die Bestrebungen der Kommission, in jedem Einzelfall ein Gleichgewicht zwischen dem Recht auf Auskunft der Rechteinhaber und dem Schutz personenbezogener Daten herbeizuführen (vgl. S. 8, Punkt 3.4 des Berichts KOM(2010) 779 endgültig).

2. Die im Bericht KOM(2010) 779 endgültig auf Seite 6, Punkt 3.2 angeregte Aufnahme einer Liste aller Rechte, die mindestens unter die Richtlinie fallen, wird vom Deutschen Bundestag abgelehnt. Die vom Anwendungsbereich der Richtlinie 2004/48/EG erfassten Rechte des geistigen Eigentums wurden bereits in der Erklärung der Kommission zu Artikel 2 dieser Richtlinie (Dok. Nr. 2005/295/EG) zutreffend und ausreichend wiedergegeben.

3. Die auf Seite 9 unter Punkt 3.6 des Berichts KOM(2010) 779 endgültig vorgeschlagene Präzisierung der Begriffsbestimmung im Hinblick auf Abhilfemaßnahmen schafft mehr Rechtssicherheit und ist somit zu begrüßen.

4. Der Vorschlag eines über die Naturalrestitution hinausgehenden Schadensersatzes (Seite 9, Punkt 3.5 des Berichts KOM(2010) 779 endgültig) wird vom Deutschen Bundestag nicht unterstützt. Der Gedanke eines Strafschadensersatzes widerspricht tragenden Grundsätzen des deutschen Rechtssystems. Dazu hat der Bundesgerichtshof in einer Grundsatzentscheidung vom 4. Juni 1992 (IX ZR 149/91) ausgeführt: „Die moderne deutsche Zivilrechtsordnung sieht als Rechtsfolge einer unerlaubten Handlung nur den Schadensausgleich (§§ 249 ff. BGB), nicht aber eine Bereicherung des Geschädigten vor. […] Die Bestrafung und – im Rahmen des Schuldangemessenen – Abschreckung sind mögliche Ziele der Kriminalstrafe (§ 46 f. StGB), die als Geldstrafe an den Staat fließt, nicht des Zivilrechts."

5. Ist der Rechtsverletzer eine juristische Person, droht die Gefahr, dass der Rechteinhaber keinen Schadensersatz erhält, weil der Rechtsverletzer vermögenslos ist, das Unternehmen aufgelöst wurde oder aus sonstigen Gründen zahlungsunfähig ist. Der Deutsche Bundestag begrüßt den Vorschlag der Kommission (Seite 9, Punkt 3.5, letzter Absatz, des Berichts KOM(2010) 779 endgültig) zu prüfen, ob und wenn ja unter welchen Voraussetzungen der Rechteinhaber nach nationalem Recht auch von der Geschäftsführung Schadensersatz verlangen kann.

6. Die Vernichtung von rechtsverletzender Ware kann nur zivilrechtlich durchgesetzt werden. Folglich müssen die dadurch entstehenden Kosten auch von den Parteien getragen werden. Der Deutsche Bundestag begrüßt daher den Vorschlag der Kommission, darüber nachzudenken, wie sichergestellt wird, dass die Gerichte die Kosten für die Vernichtung der Waren, durch welche Rechte verletzt werden, unmittelbar der unterlegenen Partei zuweisen können (Seite 9, Punkt 3.6 des Berichts KOM(2010) 779 endgültig). Insbesondere lehnt der Deutsche Bundestag

eine Kostentragungspflicht der Zollbehörden ab. Es ist nicht Aufgabe des Staates, für solche Kosten aufzukommen, die aus zivilrechtlichen Rechtsverstößen resultieren.“

Berlin, den 23. März 2011

Der Rechtsausschuss

Siegfried Kauder (Villingen-Schwenningen)
Vorsitzender

Ansgar Heveling
Berichterstatter

Stephan Thomae
Berichterstatter

Burkhard Lischka
Berichterstatter

Raju Sharma
Berichterstatter

Ingrid Hönlinger
Berichterstatterin

Bericht der Abgeordneten Ansgar Heveling, Stephan Thomae, Burkhard Lischka, Raju Sharma und Ingrid Hönlinger

I. Überweisung

Das **Ratsdokument 5140/11** wurde mit Überweisungsdrucksache 17/4768 Nr. A.4 vom 14. Februar 2011 gemäß § 93 Absatz 5 der Geschäftsordnung dem Rechtsausschuss zur federführenden Beratung und dem Ausschuss für Kultur und Medien zur Mitberatung überwiesen.

II. Stellungnahme des mitberatenden Ausschusses

Der **Ausschuss für Kultur und Medien** hat die Vorlage auf Ratsdokument 5140/11 in seiner 34. Sitzung am 23. März 2011 beraten und empfiehlt mit den Stimmen der Fraktionen der CDU/CSU, SPD und FDP gegen die Stimmen der Fraktionen DIE LINKE. und BÜNDNIS 90/DIE GRÜNEN, die aus der Beschlussempfehlung ersichtliche Entschließung unter Kenntnisnahme der Vorlage anzunehmen.

III. Beratungsverlauf und Beratungsergebnisse im federführenden Ausschuss

Der **Rechtsausschuss** hat die Vorlage nach vorbereitenden Beratungen im Unterausschuss Europarecht in seiner 41. Sitzung am 23. März 2011 beraten und empfiehlt mit den Stimmen der Fraktionen der CDU/CSU, SPD und FDP gegen die Stimmen der Fraktion BÜNDNIS 90/DIE GRÜNEN bei Stimmenthaltung der Fraktion DIE LINKE., die aus der Beschlussempfehlung ersichtliche Entschließung unter Kenntnisnahme der Vorlage anzunehmen.

Berlin, den 23. März 2011

Ansgar Heveling Berichterstatter	**Stephan Thomae** Berichterstatter	**Burkhard Lischka** Berichterstatter
Raju Sharma Berichterstatter	**Ingrid Hönlinger** Berichterstatterin	

Anlage



RAT DER EUROPÄISCHEN UNION

Brüssel, den 10. Januar 2011 (11.01)
(OR. en)

5140/11

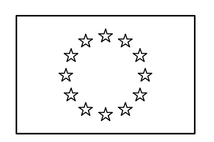
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JUSTCIV 1

ÜBERMITTLUNGSVERMERK

Absender:	Herr Jordi AYET PUIGARNAU, Direktor, im Auftrag der Generalsekretärin der Europäischen Kommission
Eingangsdatum:	22. Dezember 2010
Empfänger:	der Generalsekretär des Rates der Europäischen Union, Herr Pierre de BOISSIEU
Betr.:	Bericht der Kommission an den Rat, das Europäische Parlament, den Europäischen Wirtschafts- und Sozialausschuss und den Ausschuss der Regionen – Anwendung der Richtlinie 2004/48/EG des Europäischen Parlaments und des Rates vom 29. April 2004 zur Durchsetzung der Rechte des geistigen Eigentums

Die Delegationen erhalten in der Anlage das Kommissionsdokument KOM(2010) 779 endgültig.

Anl.: KOM(2010) 779 endgültig



EUROPÄISCHE KOMMISSION

Brüssel, den 22.12.2010
KOM(2010) 779 endgültig

BERICHT DER KOMMISSION AN DEN RAT, DAS EUROPÄISCHE PARLAMENT, DEN EUROPÄISCHEN WIRTSCHAFTS- UND SOZIALAUSSCHUSS UND DEN AUSSCHUSS DER REGIONEN

Anwendung der Richtlinie 2004/48/EG des Europäischen Parlaments und des Rates vom 29. April 2004 zur Durchsetzung der Rechte des geistigen Eigentums

SEK(2010) 1589 endgültig

BERICHT DER KOMMISSION AN DEN RAT, DAS EUROPÄISCHE PARLAMENT, DEN EUROPÄISCHEN WIRTSCHAFTS- UND SOZIALAUSSCHUSS UND DEN AUSSCHUSS DER REGIONEN

Anwendung der Richtlinie 2004/48/EG des Europäischen Parlaments und des Rates vom 29. April 2004 zur Durchsetzung der Rechte des geistigen Eigentums

ZUSAMMENFASSUNG

Wirksame Instrumente zur Durchsetzung der Rechte des geistigen Eigentums sind von grundlegender Bedeutung für die Förderung von Innovation und Kreativität. Mit der Richtlinie 2004/48/EG zur Durchsetzung der Rechte des geistigen Eigentums werden die Instrumente harmonisiert, die Rechteinhabern und Behörden für die Bekämpfung von Verletzungen der Rechte des geistigen Eigentums zumindest zur Verfügung stehen. Sie legt ferner einen grundlegenden Rahmen für den Informationsaustausch und die Verwaltungszusammenarbeit zwischen nationalen Behörden und der Kommission fest.

Eine erste Bewertung der Auswirkungen der Richtlinie zeigt, dass seit ihrer Verabschiedung und Umsetzung in den Mitgliedstaaten beachtliche Fortschritte erzielt wurden. Durch die Richtlinie wurden hohe europäische Rechtsstandards geschaffen für die Durchsetzung der unterschiedlichen Arten von Rechten, die durch unabhängige Rechtsordnungen geschützt sind (beispielsweise Urheberrecht, Patentrechte, Markenzeichen- und Gebrauchsmusterrechte, aber auch geografische Angaben und Sortenschutzrechte).

Die Durchsetzungsverfahren wurden zwar insgesamt verbessert, doch sind das schiere Volumen und der finanzielle Wert der Verletzungen von Rechten des geistigen Eigentums alarmierend. Ein Grund hierfür ist die beispiellose Zunahme der Möglichkeiten, Rechte des geistigen Eigentums zu verletzen, durch das Internet. Die Richtlinie wurde nicht mit Blick auf diese Herausforderungen konzipiert.

Andere Fragen, denen möglicherweise besondere Aufmerksamkeit gewidmet werden muss, sind der Einsatz von einstweiligen Maßnahmen und Sicherungsmaßnahmen wie etwa gerichtliche Anordnungen, Verfahren zur Sammlung und Sicherung von Beweismitteln (einschließlich des Verhältnisses zwischen dem Recht auf Auskunft und dem Schutz der Privatsphäre), die Präzisierung der Bedeutung der verschiedenen Abhilfemaßnahmen einschließlich der Vernichtungskosten und die Berechnung von Schadenersatz.

INHALTSVERZEICHNIS

1. EINLEITUNG

Es müssen unbedingt wirkungsvolle Mittel gefunden werden, um die Rechte des geistigen Eigentums durchzusetzen und Innovation und kreatives Schaffen zu fördern. Dieser Bericht enthält die erste Bewertung der Umsetzung und der Auswirkungen der Richtlinie 2004/48/EG zur Durchsetzung der Rechte des geistigen Eigentums[1] („die Richtlinie“). Dieser Bericht ist nach Artikel 18 der Richtlinie vorgeschrieben und basiert sowohl auf der Einschätzung der Entwicklungen durch die Kommission als auch auf den Rückmeldungen der Mitgliedstaaten in Form nationaler Berichte, die wiederum die Standpunkte von Industrie, Juristen, Verbraucherverbänden und sonstigen interessierten Akteuren wiedergeben.

Die eingegangenen Informationen deuten darauf hin, dass die Richtlinie wesentliche und positive Auswirkungen auf den zivilrechtlichen Schutz der Rechte des geistigen Eigentums in Europa hat. Durch die Richtlinie wurde ein klarer Rahmen für die Durchsetzung der Rechte des geistigen Eigentums geschaffen, der im Großen und Ganzen vergleichbaren Schutz über Landesgrenzen hinweg bietet. Vor allem die Urheber- oder Inhabervermutung (Artikel 5), die Möglichkeit, bei der Sammlung von Informationen eine „Auswahl“ als Nachweis anzusehen (Artikel 6), die einstweiligen Maßnahmen zur Beweissicherung (Artikel 7) und die Möglichkeit des Erlasses von gerichtlichen Anordnungen gegen Mittelspersonen (Artikel 9

[1] ABl. L 157 vom 30.4.2004, S. 16.

und 11) haben zur wirkungsvolleren Durchsetzung der Rechte des geistigen Eigentums in der EU beigetragen.

Da die Richtlinie in vielen Mitgliedstaaten spät umgesetzt wurde (der Umsetzungsprozess wurde erst 2009 abgeschlossen)[2], sind die Erfahrungen mit ihrer Anwendung nur begrenzt und es wurde nur von wenigen Gerichtsverfahren berichtet. Daher konnte die Kommission nicht die in Artikel 18 der Richtlinie vorgesehene kritische wirtschaftliche Analyse der Auswirkungen der Richtlinie auf die Innovation und die Entwicklung der Informationsgesellschaft vornehmen.

Trotz dieser Einschränkungen kommt diese erste Bewertung der Wirksamkeit der Richtlinie zur rechten Zeit. Mehrere Studien internationaler Organisationen und der Industrie haben gezeigt, dass Verletzungen der Rechte des geistigen Eigentums einen erheblichen Umfang erreicht haben, wobei einige dieser Waren die Gesundheit und Sicherheit der Verbraucher gefährden[3]. Als Reaktion darauf hat die Kommission in den vergangenen zwei Jahren zwei Mitteilungen angenommen[4]. Durch die zweite Mitteilung wurde unter anderem eine Europäische Beobachtungsstelle für Marken- und Produktpiraterie eingerichtet, um Verletzungen der Rechte des geistigen Eigentums besser erkennen zu können und eine Plattform zu schaffen, über die Vertreter der nationalen Behörden und Beteiligte Gedanken und bewährte Praktiken austauschen, gemeinsame Vollzugsstrategien entwickeln und Empfehlungen für die politischen Entscheidungsträger formulieren. Es folgten zwei Entschließungen des Rates[5] zur Unterstützung der Politik der Kommission. Der vom Europäischen Parlament angenommene Bericht unterstützte auch eine wirksame Politik einschließlich eines starken Rechtsrahmens zur Bekämpfung von Marken- und Produktpiraterie[6]. Auch außerhalb der EU begangene Verletzungen der Rechte des geistigen Eigentums geben Anlass zu großer Besorgnis. Die Kommission geht auf unterschiedliche Weise dagegen vor, beispielsweise durch ambitionierte Kapitel zu den Rechten des geistigen Eigentums in bilateralen Handelsabkommen und durch die Beteiligung an internationalen Initiativen wie etwa den laufenden Verhandlungen über das ACTA-Abkommen[7].

Die Analyse hat ergeben, dass einige Bestimmungen der Richtlinie einschließlich des Verhältnisses zu anderen Richtlinien in den einzelnen Mitgliedstaaten unterschiedlich verstanden und dadurch **in der Praxis unterschiedlich ausgelegt und angewandt werden.** Eine weitere Präzisierung dieser Bestimmungen könnte erforderlich sein, damit die Richtlinie ihre volle Wirksamkeit entfalten kann.

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[2] Die Frist für die Umsetzung der Richtlinie für die damaligen 25 Mitgliedstaaten lief am 29. April 2006 ab. Einzelheiten zum Umsetzungsprozess sind Anhang 1 zu dem diesem Bericht beigefügten Arbeitspapier der Kommissionsdienststellen zu entnehmen.

[3] Siehe beispielsweise http://www.iccwbo.org/uploadedFiles/BASCAP/Pages/OECD-FullReport.pdf; http://www.iccwbo.org/uploadedFiles/BASCAP/Pages/Building%20a%20Digital%20Economy%20-%20TERA(1).pdf.

[4] Mitteilung der Kommission vom 16. Juli 2008: „Eine europäische Strategie für gewerbliche Schutzrechte", KOM(2008)465 endgültig; Mitteilung der Kommission: „Verbesserung der Durchsetzung von Rechten des geistigen Eigentums im Binnenmarkt", KOM(2009) 467 endgültig.

[5] Entschließung des Rates vom 25. September 2008 über einen europäischen Gesamtplan zur Bekämpfung von Nachahmungen und Piraterie, ABl. C 253 vom 4.10.2008, S.1; Entschließung des Rates vom 1. März 2010 zur Verbesserung der Durchsetzung von Rechten des geistigen Eigentums im Binnenmarkt, ABl. C 56 vom 6.3.2010, S. 1.

[6] Entschließung des Europäischen Parlaments vom 22. September 2010 zur Durchsetzung von Rechten des geistigen Eigentums im Binnenmarkt (2009/2178(INI)), A7-0175/2010.

[7] Einzelheiten unter: http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2005:129:0003:0016:DE:PDF.

Das **Internet** und die digitalen Technologien bringen eine zusätzliche Herausforderung bei der Durchsetzung der Rechte des geistigen Eigentums mit sich. Einerseits hat das Internet Schöpfern und Erfindern und ihren Geschäftspartnern neue Möglichkeiten der Vermarktung ihrer Produkte eröffnet. Andererseits hat es auch schwer zu bekämpfenden neuen Formen der Verletzung von Rechten des geistigen Eigentums Tür und Tor geöffnet.

In diesem Bericht wird eine Reihe konkreter Themen angesprochen, bei denen möglicherweise eine Klarstellung erforderlich ist, vor allem die Anpassung der Richtlinie an die neuen Herausforderungen in einer modernen digitalen Gesellschaft. Er wird ergänzt durch ein Arbeitspapier der Kommissionsdienststellen, das zusätzliche Informationen und Hintergründe zu den dargelegten Erkenntnissen enthält.

2. Die Ziele der Richtlinie zur Durchsetzung der Rechte des geistigen Eigentums

Diskrepanzen zwischen den Systemen der Mitgliedstaaten zur Durchsetzung der Rechte des geistigen Eigentums beeinträchtigen das ordnungsgemäße Funktionieren des Binnenmarktes und schwächen die Durchsetzung des einschlägigen materiellen Rechts. Dadurch werden grenzübergreifende Tätigkeiten behindert, das Vertrauen in den Binnenmarkt geschwächt und Investitionen in Innovation und kreatives Schaffen verringert. Durch die Richtlinie werden die nationalen Rechtssysteme einander angenähert, um den Rechteinhabern und den Behörden der Mitgliedstaaten ein Standardinstrumentarium für die Bekämpfung von Verletzungen der Rechte des geistigen Eigentums an die Hand zu geben.

Durch die Richtlinie werden zivilrechtliche Maßnahmen im Rahmen des TRIPs-Übereinkommens[8] in den EU-Rechtsrahmen einbezogen. Sie geht über die in diesem Übereinkommen festgelegten Mindestbestimmungen hinaus, da sie beispielsweise auch Abhilfemaßnahmen und Beweise abdeckt. Außerdem basiert die Richtlinie auf den in den Rechtsvorschriften der Mitgliedstaaten festgelegten Praktiken, die sich vor der Annahme der Richtlinie als am wirksamsten erwiesen haben (der Ansatz der „bewährten Praxis“). Die Mitgliedstaaten können ferner Sanktionen und Rechtsbehelfe vorsehen, die für die Rechteinhaber günstiger sind[9]. Daher bietet die Richtlinie einen Mindestrechtsrahmen für die Durchsetzung der Rechte des geistigen Eigentums, der aber flexibel ist.

3. Für einen wirksameren Schutz der Rechte des geistigen Eigentums und einen besser funktionierenden Binnenmarkt können Präzisierungen erforderlich sein

Wie die Analyse der Umsetzung der Richtlinie in den Mitgliedstaaten zeigt, liefert die Richtlinie ein solides Fundament für die Durchsetzung der Rechte des geistigen Eigentums im Binnenmarkt, doch ist möglicherweise eine gewisse Präzisierung erforderlich, um jede

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8 Übereinkommen über die handelsbezogenen Aspekte der Rechte an geistigem Eigentum (TRIPs-Übereinkommen) von 1994; Beschluss des Rates vom 22. Dezember 1994 über den Abschluss der Übereinkünfte im Rahmen der multilateralen Verhandlungen der Uruguay-Runde (1986-1994) im Namen der Europäischen Gemeinschaft in Bezug auf die in ihre Zuständigkeiten fallenden Bereiche (94/800/EG), ABl. L 336, S.1.

9 Siehe Artikel 2 Absatz 1 der Richtlinie.

Unklarheit zu vermeiden und die Richtlinie an die neuen Herausforderungen, vor allem des aktuellen digitalen Umfelds, anzupassen.

3.1. Spezifische Herausforderungen des digitalen Umfelds

Die Vielfalt des Internet erleichtert es, zahlreiche Verletzungen der Rechte des geistigen Eigentums zu begehen. Waren, durch die Rechte des geistigen Eigentums verletzt werden, werden im Internet zum Kauf angeboten. Suchmaschinen ermöglichen es Betrügern häufig, Internetnutzer für ihre zum Kauf oder als Download verfügbaren rechtswidrigen Angebote zu interessieren. Die gemeinsame Nutzung von Dateien mit urheberrechtsgeschützten Inhalten ist mittlerweile gang und gäbe, teilweise deshalb, weil die Entwicklung der legalen Angebote von digitalen Inhalten nicht mit der Nachfrage (vor allem grenzüberschreitend) Schritt halten konnte; dies hat dazu geführt, dass viele gesetzestreue Bürger massive Verletzungen des Urheberrechts und der verwandten Schutzrechte in Form von illegalem Hochladen und illegaler Verbreitung geschützter Inhalte begehen. Viele Websites hosten oder erleichtern die Online-Verbreitung geschützter Werke ohne Zustimmung der Rechteinhaber. In diesem Zusammenhang müssen möglicherweise die Grenzen des bestehenden Rechtsrahmens eindeutig geprüft werden.

3.2. Der Anwendungsbereich der Richtlinie

Die Richtlinie gilt für alle Verletzungen der Rechte des geistigen Eigentums, die durch europäisches oder nationales Recht geschützt sind, und enthält keine Begriffsbestimmungen der Rechte des geistigen Eigentums, die sie abdeckt. Obgleich dieser flexible Ansatz eine Reihe von Vorteilen bietet, hat die unterschiedliche Auslegung des Konzepts des „Rechts des geistigen Eigentums“ die Mitgliedstaaten bewogen, die Kommission um die Veröffentlichung einer Liste von Rechten des geistigen Eigentums zu ersuchen, die mindestens unter die Richtlinie fallen[10].

Auch nach Veröffentlichung dieser Klarstellung durch die Kommission bestehen Unsicherheiten in Bezug darauf fort, ob einige nach nationalem Recht geschützte Rechte unter die Richtlinie fallen. Dies gilt hauptsächlich für Domänennamen, nationale Rechte zu Themen wie Geschäftsgeheimnisse (einschließlich Know-how) und andere häufig unter nationale Gesetze gegen den unlauteren Wettbewerb fallende Akte wie Produktpiraterie oder sonstige Formen von „Wettbewerb am Rande des Gesetzes“. Auch diese Formen geschäftlichen Fehlverhaltens scheinen zuzunehmen. Sie haben oft schädliche Auswirkungen für die Rechteinhaber, beeinträchtigen die Innovation und bringen den Verbrauchern nur kurzfristigen Nutzen. Es könnte sinnvoll sein, dieses Phänomen sowie die Notwendigkeit, in die Richtlinie eine Liste der Rechte des geistigen Eigentums aufzunehmen, die mindestens unter die Richtlinie fallen, weiter zu prüfen.

3.3. Das Konzept der Mittelspersonen und die Praktikabilität von gerichtlichen Anordnungen

Durch die Richtlinie wird das Konzept der „Mittelsperson“ weit ausgelegt, damit alle Mittelspersonen einbezogen sind, „deren Dienste *von einem Dritten* zwecks Verletzung eines Rechts des geistigen Eigentums in Anspruch genommen werden“. Das bedeutet, dass diese in

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[10] Erklärung der Kommission zu Artikel 2 der Richtlinie 2004/48/EG des Europäischen Parlaments und des Rates zur Durchsetzung der Rechte des geistigen Eigentums (2005/295/EG), ABl. L 37 vom13.4.2005, S.37.

der Richtlinie festgelegten Maßnahmen auch für Mittelspersonen ohne direktes Vertragsverhältnis oder direkte Verbindung zum Rechteverletzer gelten.

Dennoch werden von den Gerichten der Mitgliedstaaten im Allgemeinen eindeutige Beweise verlangt. Zudem besteht weiterhin Unsicherheit darüber, welche besonderen Maßnahmen, unabhängig von ihrer Haftung, für Mittelspersonen gelten, die zur Verletzung von Rechten des geistigen Eigentums beigetragen oder sie erleichtert haben.

Mittelspersonen, die Waren befördern, bei denen der Verdacht einer Verletzung der Rechte des geistigen Eigentums besteht (wie Transportunternehmen, Spediteure oder Schiffsagenten/Schiffsspediteure), können eine führende Rolle spielen bei der Kontrolle des Vertriebs von Waren, durch die Rechte des geistigen Eigentums verletzt werden. Auch Internetplattformen wie beispielsweise Online-Märkte oder Suchmaschinen können eine wichtige Rolle spielen, wenn es darum geht, die Zahl der Verletzungen der Rechte des geistigen Eigentums zu verringern, vor allem durch Präventivmaßnahmen und Verfahren zur Meldung und Entfernung rechtswidriger Inhalte.

Anbieter von Internetdiensten sind auch der Schlüssel zur Arbeitsweise des Online-Umfelds. Sie bieten Zugang zum Internet und verbinden die zugrundeliegenden Netze, Host Websites und Server miteinander. Als Vermittler zwischen allen Internetnutzern und den Rechteinhabern befinden sie sich durch rechtswidrige Handlungen ihrer Kunden häufig in einer heiklen Lage. Aus diesem Grund enthält das EU-Recht bereits besondere Bestimmungen zur Begrenzung der Verantwortlichkeit von Internetdiensteanbietern, deren Dienste zur Verletzung von Rechten des geistigen Eigentums genutzt werden[11].

Die gegenüber Vermittlern zu ergreifenden Maßnahmen betreffen vor allem das Recht auf Auskunft, die einstweiligen Maßnahmen und Sicherungsmaßnahmen (z. B. einstweilige gerichtliche Anordnungen) oder dauerhafte gerichtliche Anordnungen.

Die Richtlinie überlässt es den Mitgliedstaaten, zu entscheiden, wann und wie eine gerichtliche Anordnung gegen einen Vermittler erlassen werden kann. Damit dies effizient funktioniert, könnte es von Nutzen sein, klarzustellen, dass gerichtliche Anordnungen nicht von der Haftung des Vermittlers abhängen sollten. Darüber hinaus deuten die im Arbeitspapier der Kommissionsdienststellen aufgeführten Erkenntnisse darauf hin, dass die derzeit verfügbaren legislativen und nichtlegislativen Instrumente nicht ausreichen, um Online-Verletzungen von Rechten des geistigen Eigentums wirksam zu bekämpfen. Da der Vermittler sich im Hinblick auf Prävention und Beendigung der Online-Verletzungen von Rechten des geistigen Eigentums in einer günstigen Position befindet, könnte die Kommission untersuchen, wie er enger eingebunden werden kann.

3.4. Die Frage des ausgewogenes Verhältnisses zwischen dem Recht auf Auskunft und den Rechtsvorschriften zum Schutz der Privatsphäre

Das Recht auf Auskunft verpflichtet den Rechteverletzer oder eine andere Person, dem Rechteinhaber Auskünfte über den Ursprung und die Vertriebswege von Waren, durch die ein Recht des geistigen Eigentums verletzt wird, zu erteilen. Die größte Herausforderung

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[11] Richtlinie 2000/31/EG vom 8. Juni 2000 über bestimmte rechtliche Aspekte der Dienste der Informationsgesellschaft, insbesondere des elektronischen Geschäftsverkehrs, im Binnenmarkt (Richtlinie über den elektronischen Geschäftsverkehr), ABl. Nr. L 178 vom 17. Juli 2000, S. 1.

hinsichtlich dieses Rechts besteht in der Notwendigkeit, die Rechtsvorschriften zum Schutz der Privatsphäre und zum Schutz der personenbezogenen Daten zu achten.

In einigen Mitgliedstaaten scheint das in der Richtlinie genannte Recht auf Auskunft sehr restriktiv gehandhabt zu werden, vor allem aufgrund der nationalen Rechtsvorschriften für Schutz und Speicherung personenbezogener Daten[12]. Diesen Fragen könnte besondere Aufmerksamkeit gewidmet werden. Die nationalen Rechtsvorschriften müssen den Gerichten die Anwendung des EU-Rechts zur Durchsetzung der Rechte des geistigen Eigentums ermöglichen. Dem Gerichtshof der Europäischen Union zufolge muss ein angemessenes Gleichgewicht zwischen den verschiedenen geschützten Rechten (beispielsweise dem Datenschutzrecht und dem Eigentumsrecht, das die Rechte des geistigen Eigentums umfasst)[13] hergestellt werden, da sowohl der Datenschutz/die Privatsphäre als auch der Schutz der Rechte des geistigen Eigentums in der Charta der Grundrechte der Europäischen Union als Grundrechte anerkannt sind[14].

Der europäische Rechtsrahmen für den Schutz personenbezogener Daten[15] einerseits und die Durchsetzung der Rechte des geistigen Eigentums andererseits sind insofern neutral, als es keine Regel gibt, die besagt, dass das Recht auf Privatsphäre generell Vorrang vor dem Eigentumsrecht haben sollte oder umgekehrt. Die nationalen Rechtsvorschriften zur Umsetzung der einzelnen Richtlinien müssen daher so gestaltet sein, dass in jedem Einzelfall ein Gleichgewicht zwischen diesen Rechten hergestellt wird, damit gewährleistet ist, dass die Bestimmung über das Recht auf Auskunft die Rechteinhaber wirksam schützt, ohne Rechte in Zusammenhang mit dem Schutz personenbezogener Daten zu gefährden. Möglicherweise muss weiter geprüft werden, in welchem Umfang die Rechtsvorschriften der Mitgliedstaaten und deren Anwendung diesen Anforderungen gerecht werden. Gegebenenfalls könnten auch Rechtsmittel und die Herstellung eines angemessenen Gleichgewichts zwischen den betreffenden Rechten in Betracht gezogen werden.

3.5. Die ausgleichende und abschreckende Wirkung von Schadenersatz

Die in der Richtlinie vorgesehenen Maßnahmen, Sanktionen und Rechtsmittel müssen wirksam, verhältnismäßig und abschreckend sein. Derzeit ist der in Fällen der Verletzung von Rechten des geistigen Eigentums verhängte Schadenersatz relativ gering. Nur einige wenige Mitgliedstaaten haben als Ergebnis der Umsetzung der Richtlinie einen Anstieg des verhängten Schadenersatzes gemeldet.

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[12] Beispiele sind der Studie „Online Copyright Enforcement and Data Protection in Selected Member States“ von 2009 zufolge (Hunton & Williams, Brüssel, http://ec.europa.eu/internal_market/iprenforcement/docs/study-online-enforcement_en.pdf), Österreich und Spanien.

[13] Urteil vom 29. Januar 2008 in der Rechtssache C-275/06 (Productores de Música de España (Promusicae) gegen Telefónica de España SAU); Urteil vom 19. Februar 2009 in der Rechtssache C-557/07 LSG-Gesellschaft zur Wahrnehmung von Leistungsschutzrechten GmbH gegen Tele2 Telecommunication GmbH.

[14] Artikel 7, 8 und 17 Absatz 2, Charta der Grundrechte der Europäischen Union (2000/C 364/01), ABl. C364 vom 18.12.2000, S. 1.

[15] Vor allem die Richtlinie 95/46/EG zum Schutz natürlicher Personen bei der Verarbeitung personenbezogener Daten und zum freien Datenverkehr, ABl. L 281 vom 23.11.1995, S.31 und die Richtlinie 2002/58/EG über die Verarbeitung personenbezogener Daten und den Schutz der Privatsphäre in der elektronischen Kommunikation, ABl. L 201 vom 31.7.2002, S.37.

Nach Angaben der Rechteinhaber scheint Schadenersatz derzeit potenzielle Rechteverletzer nicht wirksam von illegalen Tätigkeiten abzuschrecken. Dies ist vor allem darauf zurückzuführen, dass der von Gerichten verhängte Schadenersatz nicht dem Profit entspricht, den die Rechteverletzer erzielen.

Hauptziel des Schadenersatzes ist es, die Rechteinhaber in die gleiche Lage zu versetzen wie es ohne die Rechtsverletzung der Fall gewesen wäre. Heutzutage scheinen jedoch die Gewinne der Rechteverletzer (ungerechtfertigte Bereicherung) wesentlich höher auszufallen als der dem Rechteinhaber tatsächlich entstandene Schaden. In diesen Fällen könnte in Erwägung gezogen werden, ob die Gerichte befugt sein sollten, einen der ungerechtfertigten Bereicherung des Rechteverletzers entsprechenden Schadenersatz zu verhängen, auch wenn dieser den dem Rechteinhaber tatsächlich entstandenen Schaden übersteigt. Desgleichen könnte einiges dafür sprechen, von der Möglichkeit des Schadenersatzes für andere wirtschaftliche Folgen und immaterielle Schäden häufiger Gebrauch zu machen.

In Fällen, in denen der Rechteverletzer eine juristische Person ist und der Rechteinhaber keinen Schadenersatz erhält, weil der Rechteverletzer über keine Vermögenswerte verfügt, das Unternehmen aufgelöst wurde oder aus einem anderen Grund zahlungsunfähig ist, könnte geprüft werden, ob der Rechteinhaber nach nationalem Recht von der Geschäftsführung Schadenersatz verlangen kann und wenn ja, unter welchen Bedingungen.

3.6. Abhilfemaßnahmen

Wie im Arbeitspapier der Kommissionsdienststellen eingehend dargelegt, ist möglicherweise eine weitere Präzisierung der Begriffsbestimmung der „Abhilfemaßnahmen“ erforderlich. Vor allem die Unterscheidung zwischen „Rückruf“ und „endgültiger Entfernung aus dem Vertriebsweg“ von Waren, durch die Rechte des geistigen Eigentums verletzt werden, ist in den meisten nationalen Rechtsvorschriften nicht klar. Klargestellt werden könnte ferner, wie diese Maßnahmen anzuwenden sind, wenn die Waren nicht mehr im Besitz des Rechteverletzers sind.

Schließlich könnte darüber nachgedacht werden, wie sichergestellt wird, dass die Gerichte die Kosten für die Vernichtung der Waren, durch die Rechte verletzt werden, unmittelbar der unterlegenen Partei zuweisen können.

3.7. Sonstiges

Aus der Analyse der Umsetzung der Richtlinie durch die Mitgliedstaaten haben sich eine Reihe weiterer Fragen ergeben, die auf EU-Ebene weiter erörtert werden könnten.

Erstens scheinen die Mitgliedstaaten selten von den fakultativen Vorschriften Gebrauch zu machen (z. B. in Bezug auf Vorlage- und Besichtigungsansprüche, denen gemäß ein Justizangestellter berechtigt ist, die Räumlichkeiten des mutmaßlichen Rechteverletzers zu betreten und die Lage zu prüfen. Diese fakultative Bestimmung der Richtlinie wurde von einigen Mitgliedstaaten für Zivilverfahren nicht umgesetzt, weshalb diese Maßnahme nur im Rahmen eines Strafverfahrens zur Verfügung steht). Noch seltener sind die Fälle, in denen die Mitgliedstaaten gemäß Artikel 2 Absatz 1 Rechtsvorschriften verabschiedet haben, die für die Rechteinhaber günstiger sind als die Bestimmungen der Richtlinie. Die Gründe hierfür könnten eingehender geprüft werden. Auch die Verknüpfung des Erfordernisses des „gewerblichen Ausmaßes“ (d.h. dass eine Rechtsverletzung zwecks Erlangung eines unmittelbaren oder mittelbaren wirtschaftlichen oder kommerziellen Vorteils vorgenommen

wurde) mit dem Recht auf Auskunft in den Bestimmungen einiger Mitgliedstaaten könnte näher untersucht werden

Zweitens könnte geprüft werden, welche Optionen für die Behandlung von Problemen bei der Beweiserhebung in grenzübergreifenden Fällen zur Verfügung stehen und ob es notwendig ist, genauer zu definieren, was als „in der Verfügungsgewalt" einer Partei in einem Gerichtsverfahren erachtet werden kann (Artikel 6 Absatz 1). Weiterer Prüfung könnte ebenfalls bedürfen, ob die derzeitigen Regelungen für die Beweiserhebung in Fällen, bei denen es um vertrauliche Informationen geht, vor allem in Zusammenhang mit einstweiligen Maßnahmen, und in Fällen, in denen unterschiedliche nationale Konzepte zum Tragen kommen, in der Praxis Probleme aufwerfen.

Schließlich könnten der Nutzen der Harmonisierung der Zweitnutzung von Waren, durch die Rechte des geistigen Eigentums verletzt werden, und möglicherweise mit dieser Harmonisierung verbundene Probleme untersucht werden.

4. SCHLUSSFOLGERUNG

Verletzungen von Rechten des geistigen Eigentums fügen der Wirtschaft weitreichenden Schaden zu. Außerdem werden Gesundheit und Sicherheit der Verbraucher inzwischen durch eine erhebliche Zahl gefälschter Produkte gefährdet. Der wirksame Schutz der Rechte des geistigen Eigentums ist von grundlegender Bedeutung für die Förderung von Innovation und Kultur in einer wettbewerbsfähigen, wohlstandschaffenden und wissensbasierten Wirtschaft. Dabei müssen unterschiedliche Interessen sorgfältig gegeneinander abgewogen werden. Zu diesem Zweck wird die Kommission weiterhin aktiv mit allen Beteiligten zusammenarbeiten.

Die wichtigste Schlussfolgerung dieser ersten Bewertung der Richtlinie ist, dass die Richtlinie wesentliche und positive Auswirkungen auf den zivilrechtlichen Schutz der Rechte des geistigen Eigentums in Europa hat. Es hat sich jedoch gezeigt, dass die Richtlinie nicht mit Blick auf die Herausforderung konzipiert wurde, die das Internet für die Durchsetzung der Rechte des geistigen Eigentums darstellt. Außerdem könnten einige Themen weiterer Aufmerksamkeit bedürfen. Genannt werden könnten hier unter anderem der Einsatz von einstweiligen Maßnahmen und Sicherungsmaßnahmen wie etwa gerichtlichen Anordnungen, Verfahren zur Sammlung und Sicherung von Beweismitteln (einschließlich des Verhältnisses zwischen dem Recht auf Auskunft und dem Schutz der Privatsphäre), die Präzisierung der Bedeutung der verschiedenen Abhilfemaßnahmen einschließlich der Vernichtungskosten und die Berechnung von Schadenersatz.

Damit die Entscheidungen der Kommission über möglicherweise in Betracht gezogene künftige Maßnahmen auf eine bessere Grundlage gestellt und die gründliche Folgenabschätzung der Kommission in Bezug auf die in diesem Bericht genannten Themen untermauert wird, bittet die Kommission um Rückmeldungen von Seiten des Europäischen Parlaments, des Ministerrates, der Mitgliedstaaten, des Europäischen Wirtschafts- und Sozialausschusses und aller anderen interessierten Akteure zu diesem Bericht bis **31. März 2011**.



COUNCIL OF THE EUROPEAN UNION

Brussels, 10 January 2011

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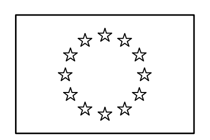
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COVER NOTE

from:	Secretary-General of the European Commission, signed by Mr Jordi AYET PUIGARNAU, Director
date of receipt:	22 December 2010
to:	Mr Pierre de BOISSIEU, Secretary-General of the Council of the European Union
Subject:	COMMISSION STAFF WORKING DOCUMENT Analysis of the application of Directive 2004/48/EC of the European Parliament and the Council of 29 April 2004 on the enforcement of intellectual property rights in the Member States - Accompanying document to the Report from the Commission to the Council, the European Parliament and the European Social Committee on the application of Directive 2004/48/EC of the European Parliament and the Council of 29 April 2004 on the enforcement of intellectual property rights

Delegations will find attached Commission document SEC(2010) 1589 final.

Encl.: SEC(2010) 1589 final



EUROPEAN COMMISSION

Brussels, 22.12.2010
SEC(2010) 1589 final

COMMISSION STAFF WORKING DOCUMENT

Analysis of the application of Directive 2004/48/EC of the European Parliament and the Council of 29 April 2004 on the enforcement of intellectual property rights in the Member States

Accompanying document to the

Report from the Commission to the Council, the European Parliament and the European Social Committee on the application of Directive 2004/48/EC of the European Parliament and the Council of 29 April 2004 on the enforcement of intellectual property rights

COM(2010) 779 final

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1. INTRODUCTION AND GENERAL REMARKS

Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights[1] (hereinafter referred to as the "Directive") was to be transposed by 29 April 2006. Article 18 of the Directive requires Member States to submit to the Commission a report on the implementation of the Directive three years after that date.

The Commission Report on the application of Directive 2004/48/EC of the European Parliament and the Council of 29 April 2004 on the enforcement of intellectual property rights, which is complemented by this Staff Working Document, is provided in application of Article 18 of the Directive. The report shall include an assessment of the effectiveness of the measures taken, as well as an evaluation of its impact on innovation and the development of the information society.

The Report is based on the reports received from the Member States according to Article 18 of the Directive but also on the Commission's own assessment of the situation and on feedback received from stakeholders and legal practitioners.

Due to the late transposition of the Directive in many Member States and the fact that some Member State did not provide the application report provided for in the Directive[2] or provided only some information of a very general nature, the information available on the impact of the Directive is too limited to allow for a full assessment of its effectiveness at this stage (see Annex 3 for further detail on the methodology of this report). However, in the context of the European Observatory on Counterfeiting and Piracy, DG Internal Market and Services works with experts from the private sector to assess the application of the Directive and to complete the information received from the Member States. Although this work is still continuing, the information received so far allows already identifying a certain number of issues related to the Directive that deserve attention.

This paper (1) chronologically describes the transposition of the different articles of the Directive by the Member States and their application in practice, problems which have arisen in the interpretation of some provisions but also sets out other issues that currently are not explicitly covered by the Directive but have proved to be of importance for an effective enforcement of intellectual property rights, and (2) draws a number of conclusions as to the issues that could be addressed in the context of a possible review of the Directive.

2. THE TRANSPOSITION OF THE DIRECTIVE BY THE MEMBER STATES AND ITS APPLICATION IN PRACTICE

The Directive's provisions (only) relate to civil law measures to enforce intellectual property rights. They encompass, in particular, evidence-gathering powers for judicial authorities, powers to force offenders and any other party commercially involved in an infringement to provide information on the origin of the infringing goods and of the distribution networks, provisional and precautionary measures such as interlocutory injunctions or seizures of suspect goods, corrective measures including permanent injunctions, recall and definitive

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[1] OJ L 157, 30.04.2004, p. 16.

[2] For details on the transposition process and the reports received from the Member States see Annex 1.

removal of the infringing goods from channels of commerce, powers to force offenders to pay damages and measures related to the publication of judicial decisions.

2.1. Subject Matter and Scope of Application (Articles 1 and 2)

The Directive covers all infringements of intellectual property rights[3] without containing any definition of **intellectual property rights**. The scope is not limited to those rights harmonized at EU level, but also covers rights protected as intellectual property rights by national law.

This technique used by the Directive has the advantage of providing a high degree of flexibility as the Directive's scope adapts to changing definitions of intellectual property rights, both at EU and at national level. However, several questions remain open. Thus, some uncertainties have arisen as to whether **domain names, trade (business) secrets**, including know-how, are covered by the Directive, and whether the Directive is applicable to other acts of **unfair competition** (for example parasitic copying). The status and the form of protection of trade (business) secrets, including know-how, and the treatment of acts of unfair competition and of domain names is very different among Member States. It seems to derive from the wording of the Directive that in cases where they are protected as an intellectual property right at national level, they should be understood as being covered by the scope of the Directive. However, in view of the diverging interpretations in the Member States it could be important to provide some clarification in that respect.

Article 2(1) of the Directive states that Member States may provide for sanctions and remedies that are more favourable to rightholders. The Directive therefore provides only for **minimum harmonisation** as far as enforcement measures are concerned. Some Member States have gone beyond the Directive's provisions and have introduced stricter measures. From the Commission's observations as well as from the stakeholders' consultation it however appears, that this was only the case for a few provisions in the Directive. One of the examples where some Member States have gone beyond the Directive's wording was the right of information (Article 8) which, according to the Directive, is limited to the activities carried out on a commercial scale if the request is not directed towards the infringer. A significant number of Member States (e.g. Denmark, Estonia, Greece, France, Lithuania, Slovak Republic) have gone beyond the ‘commercial scale’ requirement (of which there is no definition in the Directive) and introduced this measure for all infringements (for more details see section 2.3.2). Another example where Member States have gone beyond the Directive's provisions was damages. As far as damages are concerned, most Member States did not specifically implement the Directive's provisions as they felt that their national laws already covered them sufficiently. However, as far as lump sum damages are concerned, some Member States (e.g. Austria, Belgium, Greece, Czech Republic, Lithuania, Poland, Romania, Slovenia) have moved beyond the Directive's provisions and introduced multiple damages awards. Such multiple (mostly double) awards are available for copyright (and rights related to copyright) infringements or for infringements committed in bad faith.

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[3] In this paper, the term ‘intellectual property rights’ is deemed to cover all rights set out in the "Statement by the Commission concerning Article 2 of Directive 2004/48/EC of the European Parliament and of the Council on the enforcement of intellectual property rights (2005/295/EC)", OJ L94, 13.04.2005, p. 37. These include copyright, rights related to copyright, sui generis right of a database maker, rights of the creator of the topographies of a semiconductor product, trademark rights, design rights, patent rights (including rights derived from supplementary protection certificates), geographical indications, utility model rights, plant variety rights and trade names, in so far as they are protected as exclusive property rights under the national law concerned.

At the same time, several voluntary provisions of the Directive have not been implemented by the Member States. It has been observed that these cases are more numerous than those where Member States provided for stricter measures. As an example, many Member States have opted for non-transposition of the alternative measures provided for in Article 12 of the Directive (e.g. Austria, Belgium, France, Luxembourg, the Netherlands, and Slovenia). Likewise, many Member States (e.g. Czech Republic, Greece, Hungary, Malta, and Poland.) have opted for non-implementation of description orders (Article 7(1)), which are often available in criminal proceedings only.

2.2. General provisions (Articles 3 to 5)

As a procedural law, the Directive shall not affect substantive law on intellectual property, Member States' international obligations (notably the TRIPS Agreement[4]) including Member States provisions on criminal law.

Article 3 introduces the **general principle** that Member States shall provide for fair and equitable measures, procedures and remedies to ensure the enforcement of the intellectual property rights covered by this Directive. These measures, procedures and remedies shall also be effective, proportionate and dissuasive and shall be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse.

Articles 4 deals with the **persons entitled to have access to courts in order to seek application of the measures, procedures and remedies** laid down in the Directive. This group not only includes the right holders but also all other persons authorised to use those rights, especially licensees, as well as collective rights management bodies and professional defence bodies. While the former had already been protected by Member States' laws before the Directive was adopted, a majority of Member States had to amend their legislation to include professional associations established for the protection of intellectual property rights.

Article 5 governs the **presumption of authorship or ownership**. This provision is based on the wording of Article 15 of the Berne Convention[5] and, in addition, extends it also to the owners of related rights. Requiring detailed and complex proof of copyright in the past often caused substantial delays or proceedings and lead to inefficient judicial proceedings. Article 5 therefore introduced a mechanism providing that, in the absence of proof to the contrary, it is sufficient for the name of the author to appear on the work "in the usual manner", which is also applicable to the holders of rights related to copyright with regard to their protected subject matter.

This tool turned out to be particularly helpful for the various rightholders to fight against infringers' attempts to delay artificially the proceedings, in some cases without appropriate evidence, by denying the ownership of copyright holders. It allowed namely phonogram producers to initiate court proceedings on behalf of various right holders more easily. Furthermore, some rightholders reported that the presumption has made it easier to obtain cease-and-desist declarations from infringers, and has therefore had the effect of reducing the number of court proceedings. A majority of Member States had to adapt their legislation to

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[4] Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) of 1994; Council Decision (of 22 December 1994) concerning the conclusion on behalf of the European Community, as regards matters within its competence, of the agreements reached in the Uruguay Round multilateral negotiations (1986-1994) (94/800/EC), OJ L 336, p.1.

[5] Berne Protection for the Protection of Literary and Artistic Works of 9 September 1886.

this provision, in particular by stating that the name appearing on the work shall be admissible as proof of the holder of the right.

2.3. Gathering of Evidence and Measures to Preserve Evidence (Articles 6 and 7)

Articles 6 and 7 of the Directive set out a number of obligations on Member States with regard to gathering of evidence and measures to preserve evidence. The aim of these measures is to produce evidence of the infringement to courts, even where it is not in the possession of the right holder. This evidence includes information on the infringing products, on the means of production, the extent of the infringement etc., i.e. all the information that is indispensable for establishing an infringement of an intellectual property right.

2.3.1. Evidence gathering and preservation for all infringements of intellectual property rights

Article 6(1) lies down that if the rightholder has presented reasonably accessible evidence sufficient to support his claims and has, in substantiating those claims, specified evidence which lies in the control of the opposing party, the competent judicial authority may order that the opposing party produce evidence under its control. This provision was partly inspired by Article 43 of the TRIPS Agreement but in addition enables Member States to provide that courts may consider a sample of copies to constitute sufficient evidence for the entire infringement (so called '**sampling**'). It has to be noted that sampling was already known in some Member States before the adoption of the Directive[6] but was a novel provision in a large majority of Member States.[7] In a large number of Member States, stakeholders acknowledged that the possibility of using sampling led to an improvement in enforcing intellectual property rights, especially for the protection of copyright.[8]

Article 7 requires that the Member States shall, even before the commencement of proceedings on the merits of the case, order prompt and effective **provisional measures to preserve relevant evidence**, subject to the protection of confidential information. Such measures may include the detailed **description** (search), with or without the taking of samples, the physical **seizure** of the infringing goods and, in appropriate cases, of materials and implements used in the production and/or distribution of these goods and the documents relating thereto. Where necessary, these measures shall be taken without the other party having been heard. They shall be revoked or cease to have effect if the applicant does not initiate, within a period specified by the Directive, proceedings leading to a decision on the merits of the case before the competent judicial authority. In that case or where the infringement of the intellectual property right was not established in the judicial proceeding, the judicial authorities shall have the power to order the applicant to provide the defendant with an appropriate compensation for any injury caused by those measures.

As far as Articles 6 and 7 are concerned, the Directive goes beyond the TRIPS agreement but it also follows a Member States' *best practice approach* in the sense that it was inspired by those national provisions which proved to be effective for the enforcement of intellectual property rights. For example, Article 6(2) was based on the so-called 'Mareva injunction'[9] in

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6 E.g. France, Hungary.

7 The possibility of using sampling was introduced in Germany for instance only in 2008.

8 Such feedback was received e.g. from stakeholders from Cyprus, Germany, Italy, Lithuania; Poland (for trademarks), Romania.

9 Mareva Compania Naviera SA v International Bulkcarriers SA [1975] 2 Lloyd's Rep 509.

the UK and in Ireland. Similarly, Article 7 was largely inspired by the practices in some Member States such as the UK ('Anton Pillar order')[10] or France ('saisie-contrefaçon')[11].

In a number of Members States, the Directive's rules on the presentation and preservation of evidence have lead to important changes in their national legislation.[12]

Many Member States have, however, not made use of the options provided for by Article 7 of the Directive. One example are **description (search) orders** (Article 7 (1)) since this measure is more common in the context of criminal proceedings than for civil ones. Likewise, the **protection of witnesses' identity** (Article 7(5)) in Member States is often used rather in criminal than in civil proceedings. For some other Member States, this type of measure was already part of the general procedural laws and was therefore not transposed specifically with a view to proceedings on infringements of intellectual property rights. As far as **'sampling'** is concerned, it appears from information provided by stakeholders that, despite it being a voluntary provision, it has been implemented in a vast majority of Member States.

In practice, problems concerning evidence gathering and preservation have been observed in a number of areas. Thus, stakeholders and in particular legal practitioners report that **cross-border collection of evidence** in the context of judicial proceedings remains difficult. There are different ways to improve the collection of evidence across borders. A first way could be to improve the rules on jurisdiction of the courts to issue provisional, including protective measures, so as to ensure that they cover protective orders aiming at obtaining information and evidence as referred to in Articles 6 and 7 of the Directive. Another way could be to ensure that when a court is faced with a measure granted by a foreign court which is not known in its own State, it shall, to the extent possible, adapt the measure to one known under its own law. Finally, it could be very useful to improve the free circulation of measures ordered *ex parte* within the European Union. Necessary steps in this regard are being undertaken in the context of the upcoming revision of Council Regulation (EC) No 44/2001 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (Brussels I Regulation).

Gathering evidence in relation to the infringements committed via the **Internet** is becoming another significant problem. The relative anonymity of the Internet makes it often difficult to pursue the infringers. Infringers (such as sellers or owners of the websites selling/facilitating the sale of the infringing items) cannot be properly identified. Evidence in a digital form is hard to preserve and images reflecting the content of a webpage at a certain moment (so-called 'screenshots') are often not accepted by the courts as sufficient evidence. This has led several Member States to concluding, in their reports addressed to the Commission, that greater attention needs to be given to the infringements of intellectual property rights on the Internet and that the Directive does not sufficiently address this constantly growing, serious problem.

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[10] Anton Piller KG v Manufacturing Processes Limited [1975] EWCA Civ 12). In Ireland, the so-called Anton Pillar Order was formalised by law.

[11] In France and in Belgium, before the transposition of Directive the well known procedure called "saisie-contrefaçon" was only available for the certain intellectual property rights such as patents, trademarks and designs. This procedure is now available for all intellectual property rights, including geographical indications.

[12] E.g. Estonia, Lithuania and Slovenia.

Another measure which is not uniformly applied in the Member States relates to Article 6(1) according to which *"if the rightholder has presented reasonably accessible evidence sufficient to support his claims and has, in substantiating those claims,* ***specified evidence*** *which lies in the control of the opposing party the competent judicial authority may order that the opposing party produce evidence* ***under its control"***. This provision is interpreted restrictively in some Member States[13], and rightholders who ask for evidence which lies in the control of the opposing party, are frequently requested to specify the exact character, location, reference numbers and contents of the requested documents, sometimes even the page numbers of the defendant's commercial records. Where rightholders are not able to provide this information the requests are rejected by the courts as 'vague'. Stakeholders reported about a similar situation in relation to the right of information (Article 8). This practice of some courts reduces the effectiveness of Article 6 of the Directive to a considerable extent. Another issue which has arisen is how broad the term "control" should be interpreted; whether the disclosure obligation requires the person to disclose only evidence in its *possession*, whether this obligation extends to all information under its *control* (a term which is broader than 'possession') and/or whether the person is even required to undertake a *reasonable search* for evidence. The practices of the courts vary in this respect but the majority of the courts seem to limit the extent of the disclosure to the items in the *possession* of the person(s) who is (are) required to disclose. It could be useful to give more concrete guidance as to how the term 'control' should be interpreted.

2.3.2. Evidence gathering in the case of infringements committed on a commercial scale

Under Article 6(2), Member States' judicial authorities shall have the possibility to order the **communication of banking, financial or commercial documents** which are under the control of the opposing party, **in case of an infringement committed on a commercial scale**[14], subject to the protection of confidential information. This is a provision that goes beyond TRIPS, which does not contain any provision on this subject.

The Directive, however, does not contain a definition of the term 'commercial scale'.[15] Several Member States transposed this article without adding any legal definition of the term 'commercial scale', which is therefore left to the interpretation by the courts.[16] Only in few Member States the law provides for a definition of this term.[17] The definition is often given by using the notion of "commercial purpose" and defining it as *"purposes aimed at direct or indirect economic or commercial gain"* or similar.[18] These definitions are probably directly inspired by Recital 14 of the Directive according to which *"acts carried out on a commercial scale are those carried out for direct or indirect economic or commercial advantage; this would normally exclude acts carried out by end consumers acting in good faith"*. Other Member States have decided not to limit these measures to cases of commercial scale and

[13] E.g. Greece.

[14] Also Articles 8(1) - right of information (in case the request is not directed towards the infringer) - and 9(2) - seizure of the movable and immovable property, including the blocking of the infringer's bank account and other assets - are limited to the case of infringements committed on a commercial scale.

[15] Recital 14 of the Directive however states that that acts carried out on a commercial scale are "those carried out for direct or indirect economic or commercial advantage and that this would normally exclude acts carried out by end-consumers acting in good faith".

[16] E.g. Cyprus, Estonia, Hungary.

[17] E.g. Germany, Czech Republic, Romania, Slovenia. Italian scholars seem to conclude that "on a commercial scale" means "in the course of trade".

[18] Different e.g. Germany for copyright infringements ("number or severity of infringements").

allow communication of banking, financial or commercial documents for all infringements of intellectual property rights.[19]

2.3.3. Evidence and protection of confidential information

According to Article 6(1), Member States shall ensure that, on application by a party which has presented reasonably available evidence sufficient to support its claims, and has specified evidence which lies in the control of the opposing party, the competent judicial authorities may order that such evidence be presented by the opposing party, **subject to the protection of confidential information**. Also, in case an infringement is committed on a commercial scale, competent judicial authorities shall be in a position to order communication of banking, financial and commercial documents which are under control of the opposing party, **with the exception of confidential information** (Article 6(2)). Likewise, when ordering provisional measures, such as description, seizure or an injunction, due regard must be given to the protection of confidential information (Article 7(1)). Also the right of information shall be "without prejudice" to the provisions which govern the protection of **confidentiality of information sources** or the processing of personal data (Article 8(3)(e)). It appears that Member States have not specifically transposed provisions related to the protection of confidential information claiming that their previous laws contained sufficient safeguards to protect confidential information.

This restriction has shown to be particularly relevant when commercial (trade) secrets or know-how are at stake. The burden of proof usually lies with the plaintiff but some evidence needed to establish the infringement or its scale is controlled exclusively by the (alleged) infringer. In such cases it appears that the courts often find it difficult to assess and balance the rightholder's interest in the information and the alleged infringer's interest in protecting confidential information in order to prevent abuse, in particular when the parties at stake are competitors. Member States' practice, on the one hand, shows that the protection of confidential information does not mean that access to confidential information cannot be part of provisional measures. On the other hand, access to the confidential information through provisional measures (by a search, seizure or an injunction) appears to be allowed only in cases where this information is truly necessary and where this information cannot be obtained by way of other (legal) means. Furthermore, a special procedure (e.g. hearing closed for the public) is usually applied when such confidential information is to be disclosed including limitation to use this information only for the purposes of the proceedings. On the basis of the currently available information, the Commission is not in a position to judge whether this situation presents an obstacle to an effective enforcement of intellectual property rights. Therefore, more information on this matter including clarification of the conditions as to when and how, according to the jurisprudence of the national courts, such confidential information may be disclosed would appear to be useful.

2.4. Right of Information (Article 8)

Article 8 of the Directive requires Member States to enable the competent judicial authorities to order that information be provided by the infringer or another person on the **origin and distribution networks** of the goods which infringe intellectual property rights. The scope of the group of persons that can be forced to provide the information goes **beyond the infringer**. It is extended to any other person who was found in possession of the infringing goods on a

[19] For instance, in France, Poland and in Denmark this condition has not been implemented and the access to banking, financial or commercial documents is left to the appreciation of the court without this limitation. It has to be noted that in France the non-transposition of this condition is, according to the French Parliament, due to the difficulty to define properly the notion of "commercial scale".

commercial scale, or was found to be using the infringing services on a commercial scale or was found to be providing on a commercial scale services used in infringing activities or was indicated as being involved in the production, manufacture or distribution of the goods or provision of the services. Such information may be requested also from other actors like **intermediaries**, for example Internet service providers, transporters or online market places. It is important to note that this provision, due to its limitation to activities carried out on a commercial scale, does **not apply to consumers**.

The information shall comprise, firstly, the **persons involved in the infringing activitie**s. In this context, it is essential not only to identify the persons at the end of the distribution chain, but also to detect those who are "behind the scenes", often as part of complex distribution networks. Secondly, the provision allows gathering information about the **quantities produced including the price obtained**. This article substantially supplements Article 47 of the TRIPS Agreement, which gives the TRIPS members only *an option* to provide that the judicial authorities are competent to order the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the infringing goods or services and of their channels of distribution.

2.4.1. The impact of the right of information on the legislation and the jurisprudence in the Member States

In some Member States the right of information towards the alleged infringer already existed before the adoption of the Directive.[20] However, the right to obtain information from third parties not directly involved in the proceedings seems to have been a novel in most Member States. Some Member States provide for the right of information only in the context of judicial proceedings, as foreseen by the Directive, other Member States have gone beyond the Directive and provide for a right of information even before the formal proceedings, **as a provisional measure**. Some Member States seem to provide for the right of information only in cases of infringements committed on a **commercial scale.** The other Member States have moved beyond the Directive and provide for the right of information for all infringements. At least in one of these Member States, this solution was chosen because the legislator wanted to avoid the problems related to the interpretation of the commercial scale criterion[21]. In some Member States[22] (it appears that when the information request is directed towards a third party, the commercial scale requirement is applied but such requirement is not imposed in case the information is requested from the alleged infringer.

After the transposition of the Directive, national courts have seen a significant increase in requests for information. Member States and stakeholders seem to agree that this provision has improved the ability to trace infringers considerably and has facilitated a better knowledge of the infringers[23]. Furthermore, this provision has had a significant impact on the possibilities to establish the "exact quantities of infringing products involved" and therefore on the accuracy of the calculation of damages. At the same time it appears that some rightholders find it difficult to establish that the infringer has acted on a commercial scale without having obtained information from the Internet service provider, in particular on different IP addresses

[20] This was the e.g. case in the UK where, in addition to Mareva injunction and the Anton Pillar Order, the so-called "Norwich Pharmacal order" was in place.
[21] In France.
[22] E.g. Belgium, Germany, Hungary, Luxemburg, Poland.
[23] E.g. Sweden.

used by the same infringer. In general, many requests for information from third parties seem to be directed towards Internet service providers.

2.4.2. Conflicts between the right of information and the right to privacy

The right of information has become an important tool for the rightholders to pursue infringers, and frequent use of this tool by the rightholders proves this. Also the possibility of intermediaries to share the data with the rightholders would be an important element in this context. In certain areas, it however appears, that the right of information by the right holders is limited because of the national provisions on the protection of personal data. In some Member States (e.g. Spain, Austria) it seems that the disclosure of the relevant information is practically impossible in both criminal and civil proceedings.[24] This is in particular the case for IPR infringements committed via the Internet such as illegal file-sharing of protected works through peer-to-peer protocol where Internet services providers may often not be in a position to disclose alleged infringers' identities and contact details to rightholders even in the context of judicial proceedings because of the privacy laws and the protection of personal data. The situation is even more complicated if the request for information is made before the start of judicial proceedings.

The question that arises is how to strike the balance between the fundamental right to property (which includes the protection of intellectual property[25]) on the one hand and that to privacy[26] on the other. The **need to balance the various rights** was emphasized by the European Court of Justice[27] which stated that Community law requires a fair balance to be struck between the various fundamental rights protected by the Community legal order and that the authorities and courts of the Member States must not only interpret their national law in a manner consistent with the directives but also make sure that they do not rely on an interpretation which would be in conflict with those fundamental rights or with the other general principles of Community law, such as the principle of proportionality.

In those Member States where privacy laws[28] currently prevail over the right to (intellectual) property it can be difficult for the rightholders to make effective use of their right of information. However, the European legal framework on the protection of personal data/privacy on the one hand and enforcement of intellectual property rights on the other is

[24] In Spain, data may only be disclosed for the purposes of prosecution or investigation of serious criminal offences (infringement of intellectual property rights do not seem to fall within this category), and any extension would be illegal unless it would be embedded in the law. In Austria, the reform of the criminal procedure removed the possibility to bring a private criminal action ("Privatanklage") without knowing the identity of the infringer. The only possibility for rightholders now seems to be to launch a civil information claim under copyright law, which is not effective in case of temporary IP addresses. Study on Online Copyright Enforcement and Data Protection in Selected Member States, Hunton & Williams, November 2009 available at: http://ec.europa.eu/internal_market/iprenforcement/docs/study-online-enforcement_en.pdf.

[25] Article 17(2) of the Charter of Fundamental Rights of the European Union states that intellectual property shall be protected.

[26] Articles 7 and 8 of the Charter of Fundamental Rights of the European Union.

[27] Judgment of 29 January 2008 in the case C-275/06 Productores de Música de España (Promusicae) v Telefónica de España SAU; judgment of 19 February 2009 in the case C-557/07 LSG-Gesellschaft zur Wahrnehmung von Leistungschutzrechten GMBH v Tele2 Telecommunication GMBH.

[28] In particular laws implementing Directive 95/46/EC on the protection of individuals with regard to the processing of personal data and on the free movement of such data, OJ L 281, 23.11.1995, p. 31, and Directive 2002/58/EC on the processing of personal data and the protection of privacy in the electronic communications sector, OJ L 201, 31.7.2002, p. 37.

neutral, in that there is no rule that would imply that the right to privacy should generally take precedence over the right to property or vice versa. National laws implementing the various directives must therefore be construed in a way allowing a balance to be struck between these rights in each case in order to guarantee that the provision on the right of information can protect the rightholders effectively without compromising rights relating to the protection of personal data. Further evaluations could be needed on the extent to which Member States' laws and the way they are applied are consistent with these requirements. If necessary, means could be considered to remedy the situation and to strike an appropriate balance between the rights at stake.

Another obstacle faced by the rightholders when requesting information appears to be linked to the **retention of the relevant data by intermediaries**. Again, this problem seems to be most relevant in cases of infringements committed via the Internet. Often the data which are requested (for example from the Internet service providers or Internet platforms) have not been stored, or by the time the request for information is delivered, the data have already been erased. Currently, data retention is dealt with at EU level only in the Data Retention Directive[29] and in the e-privacy Directive[30].

Finally, the fact that certain types of information (e. g. clinical data) may be subject to **different confidentiality regimes in different countries** causes additional problems for rightholders. These differences lead to uncertainties as to whether information legally obtained in one country may be used in another country where it falls under confidentiality rules, and vice versa.

2.5. Injunctive relief (Articles 9 and 11)

2.5.1. Interlocutory injunctions (Article 9)

2.5.1.1. General issues

Article 9 of the Directive obliges Member States to ensure that rightholders are in a position to apply for an **injunction against the infringer** aimed at prohibiting the continuation of the infringement ('interlocutory', 'interim' or 'temporary' injunction).[31] It appears that injunctions against infringers were not new to Member States' legal systems and seem to have been widely used in the Member States even before the adoption of the Directive. Non-compliance with an injunction is sanctioned by a fine to be paid to the plaintiff[32] or to the court[33] or by criminal sanctions in some cases. The reports received from the Member States suggest that for most of them experiences with interlocutory injunctions have been rather positive. With some exceptions, interlocutory injunctions generally seem to be granted rather quickly by the courts and they often lead to a settlement between the parties so that the proceedings on the

[29] Directive 2006/24/EC on the retention of data generated or processed in connection with the provision of publicly available electronic communications services or of public communications networks and amending Directive 2002/58/EC, OJ L 105, 13.4.2006, p. 54.

[30] Directive 2002/58/EC of the European Parliament and of the Council of 12 July 2002 concerning the processing of personal data and the protection of privacy in the electronic communications sector (Directive on privacy and electronic communications), OJ L 201, 31.7.2002, p. 37.

[31] This provision was partly inspired by Article 50 of the TRIPS agreement. However, an important addition to TRIPS is that such injunctions shall also be available against intermediaries whose services are used by a third party to infringe an intellectual property right.

[32] E.g. the Netherlands.

[33] Germany, Slovak Republic and the UK.

merits of the case can be avoided. For most stakeholders, due to the length of the judicial proceedings involving infringements of intellectual property rights and the costs of the proceedings which are rarely reflected in the damages awarded in the main proceedings, interlocutory injunctions are the main enforcement remedy.

Despite this general positive assessment of the interlocutory injunctions, the information at hand suggests that the **level of evidence** required by the courts to grant an injunction differs significantly between Member States and, in general, is rather high. Whereas in cases of an infringement of a trade mark, design or copyright the **'obviousness' of the infringement** may often be assumed, in cases of patent infringements this is rarely the case. Moreover, it appears that some courts sometimes are reluctant to order an injunction unless an infringement has actually been proven, as opposed to granting an injunction for preventative reasons. In these cases, the 'sufficient degree of certainty' that is required by the courts is higher than what applicants are able to establish in practise.[34] Furthermore, in some cases, the accompanying costs appear to be rather significant, since such costs often comprise court fees, lawyers' fees, bailiff's fee and in many cases also fees of (technical) experts.[35]

2.5.1.2. Injunctions against intermediaries

The **notion of 'intermediary'** is understood broadly by the Directive and includes all persons "whose services are used *by a third party* to infringe an intellectual property right". This implies that even intermediaries who do not have a direct contractual relationship or connection with the infringer may be subject to these measures provided for in the Directive.[36]

Nevertheless, there are still uncertainties as to which kind of intermediaries, regardless of their liability, may be subject to a specific measure when contributing to or facilitating an infringement[37].

Intermediaries who transport goods suspected of infringing intellectual property rights or infringing intellectual property rights (such as carriers, freight forwarders, shipping agents or postal services) may play an important role in controlling the spreading of counterfeit goods.

Internet service providers are also key players in the functioning of the online environment. They provide, *inter alia,* access to the Internet and interconnect the underlying networks and host websites and servers. Internet service providers, being the intermediaries between all the users of the Internet, on the one hand, and the rightholders, on the other, are often placed in a compromising position due to the infringing acts of their customers. For this reason, EU law already contains specific provisions concerning Internet service providers whose services are used to infringe intellectual property rights. Nevertheless, the current EU legal framework only harmonises certain limitations of liability in relation to Internet service providers where certain conditions are satisfied, whilst not affecting the possibility of Member States' courts or

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34 In Finland, it seems to be rather difficult for the rightholders to convince the courts of the need for an interlocutory injunction, except in cases of clear online infringements.

35 Stakeholders indicate that such costs may vary between EUR 3,500 and 25,000, and in patent infringement cases up to EUR 40,000.

36 Therefore not only intermediaries used (directly) by the infringer are covered by the Directive, but also intermediaries used by a third party to infringe an intellectual property right.

37 E.g. in Sweden the notion of 'intermediaries' is limited to "*anyone who contributes to the infringement*".

administrative authorities, in accordance with Member States' legal systems, to take action in individual cases[38].

In the area of the sale of counterfeit goods over the Internet, feedback received from stakeholders indicates that intermediaries (for example online market places such as online shopping sites) have realized that the presence and the sale of counterfeit goods via their sites undermines their efforts to be regarded as a safe place to buy and sell products and that their reputation is tarnished. In many cases, these intermediaries therefore have adopted comprehensive policies on the protection of intellectual property rights which are clearly spelled out on their sites. These policies include sanctions for users which breach the rules, in particular for the repeat infringers, comprehensive notice and take-down processes and other tools that allow a timely elimination of illegal offers, the sharing of information with rightholders and reimbursement schemes for consumers who unintentionally bought counterfeit goods on their site.

All these measures have been applied without affecting the liability status of the intermediaries and have significantly contributed towards the elimination of counterfeiting on the Internet; however, problems remain.

Injunctions against intermediaries whose services are used by a third party to infringe copyright or related rights were already enshrined in Article 8(3) of Directive 2001/29/EC on the harmonisation of certain aspects of copyright and related rights in the information society[39] (and subsequently in Article 11 (third sentence) of Directive 2004/48). However, it became clear after the implementation of Directive 2001/29/EC that some Member States interpreted this provision rather restrictively, as to only provide injunctive relief against intermediaries in the context of pending court proceedings or after the decision on the merits of the case, and not as a provisional measure.

To remedy this restrictive approach, Article 9 of the Directive applies to all intellectual property rights **as a provisional measure**, i.e. irrespective as to whether the formal court proceedings on the same case are pending or not but where, nevertheless, an alleged infringer is concerned. The article therefore introduced a new element which needed to be reflected through changes in national laws in almost all Member States. It results from Member States' reports that **injunctions against intermediaries are used relatively often** as the infringers are often unknown. It has been reported by the Member States and legal practitioners that injunctions against intermediaries often encourage the infringing party to engage in settlement discussions. Several Member States stressed the importance of interlocutory injunctions in cases related to the Internet. It was pointed out that one effect of the Directive was that new measures clarified that intermediaries (e.g. Internet service providers) also have certain responsibilities (and obligations) and that they cannot rely on "absolute immunity" when intellectual property rights are infringed. Injunctions have also been successfully used towards intermediaries in order to block access to the sites which facilitate works protected by copyright or related right without the consent of the rightholder.[40]

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[38] Directive 2000/31/EC of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market (Directive on electronic commerce), OJ L 178, 17.7.2000, p.1.

[39] OJ L 167, 22.6.2001, p. 10.

[40] In Denmark, injunction against Tele 2 A/S was granted by the court to block access to a Russian website. In another case in Denmark, DMT 2 A/S (now Sonofon A/S) was required by the court to prevent access to a popular website.

However, some Member States[41] report that injunctions against intermediaries have been more difficult to apply due to difficulties to execute court orders against intermediaries who have not been parties to the proceedings.

Furthermore, it appears that in some Member States it is not possible to issue injunctions unless the liability of an intermediary is established. However, neither Article 11 (third sentence) of the Directive, nor Article 8(3) of Directive 2001/29 link **injunctions with the liability of an intermediary**. Therefore, although Directive 2000/31/EC on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market[42] (hereinafter referred to as "the e-commerce Directive") provides certain exemptions in relation to the liability of intermediaries who provide information society services where certain conditions are satisfied, such exemptions do not prevent the possibility of granting an injunction against intermediaries covered by the scope of Articles 12 to 14 of the Directive. Injunctions against intermediaries are not intended as a penalty against them, but are simply based on the fact that such intermediaries (e.g. Internet service providers) are in certain cases in the best position to stop or to prevent an infringement. This interpretation is confirmed by Articles 12(3), 13(2) and 14(3) and by Recital 45 of the e-commerce Directive[43] and Recital 59 of Directive 2001/29/EC on the harmonization of certain aspects of copyright and related rights in the information society[44].

As far as third parties are concerned, these are only addressed indirectly in Article 8(3) of Directive 2001/29 and Article 11 (third sentence) of Directive 2004/48 where Member States are required to ensure that rightholders are in a position to apply for an injunction against intermediaries whose services are used by a third party to infringe a copyright tor related right. The aim of the respective provisions of each those Directive is that injunctive relief can be granted against the intermediary irrespective whether there has been a determination of liability of the intermediary or the third party. Other than these provisions, third party liability has been left to the legal system of each Member State.

2.5.2. Permanent injunctions (Article 11)

Article 11 of the Directive requires that where a judicial decision confirming an infringement of an intellectual property right is taken, judicial authorities may issue an injunction ('permanent' injunction) **against the infringer** aimed at prohibiting the continuation of the infringement. In the same way as temporary injunctions, permanent injunctions can also be issued **against intermediaries** and they may be issued against them **irrespective of the**

41 E.g. Czech Republic, Estonia.

42 OJ L 178, 17.7.2000, p. 1.

43 Recital 45 of Directive 2000/31/EC reads: "(45) The limitations of the liability of intermediary service providers established in this Directive do not affect the possibility of injunctions of different kinds; such injunctions can in particular consist of orders by courts or administrative authorities requiring the termination or prevention of any infringement, including the removal of illegal information or the disabling of access to it.".

44 Recital 59 of Directive 2001/29/EC reads: "(59) In the digital environment, in particular, the services of intermediaries may increasingly be used by third parties for infringing activities. In many cases such intermediaries are best placed to bring such infringing activities to an end. Therefore, without prejudice to any other sanctions and remedies available, rightholders should have the possibility of applying for an injunction against an intermediary who carries a third party's infringement of a protected work or other subject-matter in a network. This possibility should be available even where the acts carried out by the intermediary are exempted under Article 5. The conditions and modalities relating to such injunctions should be left to the national law of the Member States.".

intermediaries' (potential) liability. Since injunctions against the infringers are reported as having been used by the Member States already prior to the adoption of the Directive, the Directive seems to have had a limited impact in this respect. Again, **injunctions against intermediaries** were a new element which had to be introduced into the national laws in almost all Member States.

2.5.3. Scope of the injunctions

The scope of the injunctions seems to be generally determined by the scope of the rights and/or the attacked infringement. The dictum of an injunction in the Member States differs in its degree of detail. Recently, certain problems in relation to the scope of the injunctions (both interlocutory and permanent) have arisen with a view to infringements committed through the Internet. In the **music and film sectors**, injunctions often tend to be **'title specific'**. Rightholders therefore have to provide a full list of titles when asking for an injunction and the injunction will normally relate only to the indicated titles, while infringements with a view to titles not contained in the list can continue. Similar problems seem to exist with a view to the sale of counterfeit goods via online market places.

Diverging opinions on this issue have resulted in two requests for preliminary rulings being submitted to the Court of Justice of the European Union.

In case **C-324/09 (L'Oréal v eBay)** which concerns the sale of counterfeit goods via an intermediary who is an online marketplace, the referring UK High Court of Justice asked whether the injunction as described in Article 11 of the Directive should have been interpreted as requiring Member States to ensure that the trade mark proprietor could obtain an injunction against an intermediary to prevent *further infringements* of the said trade mark, as opposed to the continuation of *that specific act of infringement*, and if so, what the scope of the injunction would be.

In another case **C-70/10 (Scarlet v SABAM)** the referring Cour d'appel de Bruxelles asked the Court of Justice of the European Union whether the national courts may also issue an injunction against intermediaries whose services are used by a third party to infringe a copyright or related right, to order an Internet service provider to introduce, for all its customers, in abstracto and as a preventive measure, exclusively at the cost of that Internet service provider and for an unlimited period, a system for filtering all electronic communications, both incoming and outgoing, passing via its services, in particular those involving the use of peer-to-peer software, in order to identify on its network the sharing of electronic files containing a musical, cinematographic or audio-visual work in respect of which the applicant claims to hold rights, and subsequently to block the transfer of such files, either at the point at which they are requested or at which they are sent. It also asked whether the principle of proportionality should be applied when deciding on the effectiveness and dissuasive effect of the measures sought.

Both procedures are currently pending before the Court of Justice of the European Union.

2.5.4. Cross-border injunctions

Cross-border injunctions pose different problems, depending on the nature of the intellectual property right that is being infringed.

In cases of infringements of **the Community trade mark**[45], or of a Community **design**[46], granting of such cross-border injunctions by the European Union trade mark courts (or European Union design courts) is foreseen by the law as these rights are unitary EU titles. Stakeholders, however, report that, in practice, cross-border injunctions are generally not granted by the courts of the Member States even in the case of these rights.

The situation is even more complex for infringements of **patent** rights, in the absence of a uniform title, i.e. an EU patent. In the late 1990s, some courts began to issue injunctions in cases of patents infringements which reached beyond the territorial boundaries of the respective jurisdiction. This "legal innovation" started in the Netherlands and was subsequently picked up by courts in various other countries. This judicial practice soon became rather controversial, with some national courts following the Dutch example (e.g. in Germany) while other courts (e.g. in the UK) refused to assume jurisdiction over foreign patents. From the perspective of patent-holders, cross-border injunctions were highly attractive since they lowered the cost of litigation and opened new avenues in terms of litigation strategy. Subsequently, the European Court of Justice issued rulings in two cases, which resulted in limiting to an important extend the practice of cross-border injunctions for patent infringements.[47] The decision of the court in *Roche v. Primus and Goldberg* effectively strongly limited the possibility to bring proceedings against several patent infringers even if patents belong to the same group of companies acting in a coordinated manner in accordance with a common policy elaborated by one of them. However, a court having jurisdiction on the basis of the defendant's domicile (Article 2 of the Regulation 44/2001) may still have the power to issue injunctions with extra-territorial effect.

As regards granting cross-border injunctions in cases of **copyright** infringements, there does not seem to be an established jurisprudence. It could therefore seem useful to examine under which conditions such injunctions can be granted. A distinction between the rules of attributing jurisdiction could be made. While the jurisdiction of a court, when based on the place where the infringement causes harm, is limited to measures concerning its own territory, no such limitation exists when jurisdiction is based on the domicile of the defendant. In this later case, cross-border injunctions are not excluded.

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45 Article 103(2) of Council Regulation (EC) No 207/2009 on the Community trade mark reads: "A Community trade mark court whose jurisdiction is based on Article 97(1), (2), (3) or (4) shall have jurisdiction to grant provisional and protective measures which, subject to any necessary procedure for recognition and enforcement pursuant to Title III of Regulation (EC) No 44/2001, are applicable in the territory of any Member State. No other court shall have such jurisdiction.".
The territorial scope of the measures ordered by a Community trade mark court, which finds that an infringement has been committed, is currently the subject of a request for preliminary ruling in the case C-235/09 before the Court of Justice of the European Union.

46 Article 90(3) of the of Council Regulation (EC) No 2002/6 on the Community design reads: "A Community design court whose jurisdiction is based on Article 82(1), (2), (3) or (4) shall have jurisdiction to grant provisional measures, including protective measures, which, subject to any necessary procedure for recognition and enforcement pursuant to Title III of the Convention on Jurisdiction and Enforcement, are applicable in the territory of any Member State. No other court shall have such jurisdiction.".

47 Judgment of 13 July 2006 in the case C-4/03 Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG (GAT v LUK); and judgment of 13 July 2006 in the case C-539/03 Roche Nederland BV and others v Frederick Primus, Milton Goldenberg (Roche v. Primus and Goldberg).

2.6. Corrective and Alternative Measures (Articles 10 and 12)

Article 10 of the Directive requires that the competent judicial authorities may order recall from the channels of commerce of goods which have been found to be infringing an intellectual property right, and in appropriate cases also materials and implements principally used in the creation or manufacture of these goods. Furthermore, their definitive removal from the channels of commerce or their destruction may be ordered. Such measures shall be carried out at the expense of the infringer.

2.6.1. Meaning and purpose of "recall and definitive removal of infringing goods from the channels of commerce"

As far as **recall and definitive removal** of infringing goods from the channels of commerce are concerned, these measures appear to have been new to most Member States' legislation on intellectual property. Only few Member States seem to have been familiar with this kind of measures from the legislation on consumer protection. However, rightholders seem to request these measures not very often. This may be due, to a large extent, to the limited enforceability of the measures, particularly when an infringer is no longer the owner of the goods which are to be recalled or definitely removed and therefore has no means to dispose of the goods (for example when the infringing goods have already reached consumers or, in certain cases, retailers). It has also been reported that the courts are rather hesitant to order recall or definitive removal of the infringing goods, in particular in cases where the goods reached the final consumers.

Furthermore, Member States have been using these measures in different ways. This may be partly due to the fact that the Directive does not define these two measures and does not define the difference between them. Most Member States seem to use 'recall' as a temporary measure, which maybe reversed following a final decision. Thus, recall seems to be used by the majority of the Member States when the goods are no longer in the possession of the defendant. The defendant then is usually ordered by the court to claim the goods back from its customers (wholesalers, distributors, retailers etc.). 'Definitive removal' indicates the finality of the ordered measure for most Member States, and in some Member States (e.g. France) an order for definitive removal is often used as a precondition for destruction. In some countries, recall and definitive removal are used without any distinction (e.g. Greece, Spain, and Romania). In Sweden a *non-exhaustive* list of measures, including those mentioned in the Directive has been introduced with explicit references to other measures, such as *alteration* or the *taking into custody for the remainder of the term of protection*. Finally, there seem to be different views as to whether these measures may be ordered by the courts only as a result of the proceedings on the merits of the case or also as a provisional measure. In some Member States (e.g. in Poland, Denmark), recall may be issued as a preliminary measure, before the proceedings on the merits are commenced. In Germany it has been reported by the stakeholders that according to the prevailing case-law, claims for recall or definitive removal may only be raised in proceedings on the merits and not in preliminary proceedings.[48]

The short time that has passed since the transposition of the Directive, in many Member States has not allowed to acquire sufficient experience, on the side of the courts, with the

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[48] Although there are some other opinions saying that recall may be included into injunction claim, in case the infringers still control the infringing goods.

corrective measures, and especially the recall and definitive removal from the channels of commerce. This makes it difficult, at this stage, to determine their overall effectiveness.

2.6.2. *Destruction of the goods as a preferred corrective measure*

Generally, the **destruction** of infringing goods seems to be the preferred (and most commonly used) corrective measure. A court decision confirming an infringement normally is the necessary precondition[49]. The destruction is provided for as a civil sanction, therefore the injured party must specifically request destruction (whereas in criminal and administrative proceedings it may be ordered by the competent court/administrative board *ex officio*). However, when the destruction of infringing goods is ordered in civil law proceedings, the question arises who should bear the costs of the destruction and the related costs of storage.

According to Article 10(2) of the Directive, these costs have to be born by the infringer (defendant). However, practice shows that these costs often have to be borne by the rightholders who then are given the right to claim reimbursement from the infringers (defendants). Moreover, when rightholders subsequently claim these costs from the infringer, the latter often turns out to be insolvent (in liquidation), which means that these costs cannot be recovered. In transhipment cases (e.g. external transit, customs warehousing etc.) the defendant is usually unknown. Good faith intermediaries/service providers are normally not ordered to pay the costs of the destruction (and related costs of storage), but there seem to be very few precedents in this respect. In Germany, it has been observed that intermediaries or service providers become subject to legal claims for destruction only, where they are either 'interferer' ('Störer') or direct contributors to the infringement. It could seem reasonable to provide that when there is a decision on the merits of the case, the costs of destruction of infringing goods should be imposed by the court directly on the unsuccessful party.

2.6.3. *Secondary use of the goods infringing intellectual property rights*

The so-called **secondary use of goods infringing intellectual property rights** consists e.g. in the removal of the infringing sign, logo or trade mark from the goods, in its recycling or its donation to charity.

This issue is not harmonized by the Directive. Consequently, practices in Member States seem to differ considerably. In some Member States it seems that goods are destroyed only if their secondary use is not possible (e.g. Italy). In other Member States secondary use appears to be permitted only in exceptional cases, and there are Member States where secondary use of goods infringing intellectual property rights does not seem to be permitted at all (e.g. France, Greece, Slovenia). Additional information is needed in order to judge what role the secondary use of goods infringing intellectual property rights should play in the context of enforcement of intellectual property rights and whether further harmonization in this respect would be useful.

2.6.4. *Alternative measures*

From information received it appears that less than half of the Member States have implemented Article 12 of the Directive which provides for an option for Member States to introduce **alternative measures** in the form of a pecuniary compensation to the injured party

[49] An exception applies in particular for geographical indications where the perishable nature of certain products requires the possibility to order their rapid destruction.

if the person that infringed the intellectual property right acted unintentionally and without negligence, if execution of other measures would cause disproportionate harm and if pecuniary compensation appears reasonably satisfactory.[50] Furthermore, in some of these Member States[51] the conditions for an 'unintentional infringement without negligence' are interpreted very narrowly given that the standards to act with due care are set at a relatively high level.

2.7. Damages and legal costs (Articles 13 and 14)

Article 13(1) of the Directive requires Member States to enable the competent judicial authorities to order the infringer who knowingly, or with reasonable grounds to know, engaged in an infringing activity, to pay the right holder damages appropriate to the actual prejudice suffered by him as a result of the infringement. Where the infringer acted in good faith (i.e. without reasonable ground to know), Member States have the possibility to allow the judicial authorities to order the recovery of profits or the payment of damages, which may be pre-established (Article 13(2)). Article 14 requires that the reasonable and proportionate legal costs and other expenses incurred by the successful party shall be borne by the unsuccessful party, unless equity does not allow it.

Since the pecuniary value of intellectual property may be rather difficult to measure, also due to its 'abstract' nature, practice has shown that assessing damages for infringements of intellectual property rights is often complicated. Damages from sales of counterfeit goods over the Internet are even more difficult to assess, and it often happens that after having been discovered, infringers quickly re-appear under a different name. This situation has not changed significantly through the entry into force of the Directive. In most cases only slight adjustments of national laws governing the calculation and award of damages were needed to make Member States comply with the Directive. However, due to the relatively low number and the considerable length of the judicial proceedings, there is **not yet an established case law** on the evaluation and assessment of damages since the transposition of the Directive in the Member States. At the same time it seems that existing judgements have not been overly explicit and detailed on how awarded damages have been calculated.

However, most rightholders report to prefer quick provisional measures (e.g. injunctions) and not damages claims as the main enforcement remedy. The reasons for this are the high costs of the proceedings which are rarely reflected in the damages awarded and the length of judicial proceedings involving infringements of intellectual property rights. Therefore damages awards in intellectual property cases are not requested by rightholders as a matter of course.

2.7.1. Calculation of damages

The Directives provides for two possibilities for the judicial authorities to determine the amount of the damages:

(1) They can base the amount on the **actual prejudice** (e.g. the rightholder's lost profits, the infringer's unfair profits, moral prejudice and other negative economic consequences);

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[50] This article was implemented e.g. by Denmark, Estonia, Germany, Lithuania, Malta, Poland, Romania and Sweden.

[51] E. g. Germany.

(2) Or they can award **lump sum damages** based on at least the *(single)* amount of royalties which would have been due if the infringer has requested authorisation to use the intellectual property right(s) in question (e.g. if an infringer had concluded a licensing agreement with a right holder).

2.7.2. Wilful and negligent infringements and infringements committed in good faith

It appears that all Member States provide for damages in cases of **wilful** or **negligent** infringements of intellectual property rights (Article 13(1)). However, some Member States also award damages for infringements committed in **'good faith'** (Article 13(2)), and therefore the mere existence of an infringement is a sufficient justification for the rightholder to claim damages. Certain specificities seem to exist for copyright infringements and for infringements of rights related to copyright where often good faith is irrelevant for claiming damages. This is different from patent infringements, where in some Member States damages may be claimed only for infringements committed intentionally.

Most Member States seem to award damages regardless of whether the infringement is committed on a **commercial scale,** and there is generally no overall limitation on damages.

2.7.3. Damages appropriate to the actual prejudice suffered by the rightholder

2.7.3.1. Rightholders' lost profits

When awarding damages, it appears that all Member States take the **rightholders' lost profits** into account. Lost profits are usually defined as profits which would have been earned by the rightholder, in the absence of the infringement, or which could have been justifiably expected (excluding the infringer's profits). Nevertheless, in some Member States it seems unclear, whether the price of the original product or the price of a counterfeit/pirated product (which may be substantially lower in some cases) should be taken into account when assessing the rightholder's lost profits. Moreover, lost profits can be difficult to prove, in particular where infringing activities undermine the value of legal sales. Extensive infringing activities often make the branded goods lose their 'exclusivity' which leads to a decline in consumer demand, damage to goodwill etc..

2.7.3.2. Infringers' profits

The **profits unlawfully made by the infringer ('unjustified enrichment')** constituted a new aspect for assessing damages in some Member States and it has been implemented into the national legislation in very different ways.

Many Member States require a rightholder to prove that profits were made with or as a result of the infringing products (causal link). Infringers may sometimes make higher profits with the infringing products than the rightholders with their branded goods. Rightholders appear to find it very difficult to prove that they would have earned the same profits as the infringers, particularly where the infringers offer their products under conditions that significantly differ from those of the legal channels (e.g. lower prices, lower manufacturing costs, absence of related services etc.). Furthermore, in some Member States[52] it appears that infringers' profits can only be taken into consideration once, either as a recovery of unfair profits or as damages

[52] E.g. Slovak Republic.

(or part of damages), but not in a cumulative way. In other Member States[53] the transfer of infringers' profits are awarded as an alternative, when the profits are higher than the rightholder's calculated damages (e.g. the rightholders' lost profits). Finally, in some Member States[54], in addition to damages, also the transfer of the infringer's profits may be ordered.

2.7.3.3. Moral damages and damages for negative economic consequences

With respect to **moral damages** (as part of immaterial damages) and damages for **negative economic consequences** (as part of material damages; for example price erosion, tarnishment of a trademark etc.), rightholders report that they are not requesting them as a matter of course, and that where such requests have been made they have only occasionally been successful. They also report that moral damages tend to be rather low.[55]

Therefore, despite the fact that rightholders have the right to claim damages in these cases it seems that damages for negative economic consequences and moral damages are rarely used in practice. It appears that one of the main reasons for this is that proving such damages may be very difficult. However, Member States' laws are too recent and too few precedents exist as this stage to properly assess the implications of this provision of the Directive in practice.

2.7.4. Lump sum damages

Member States generally provide for lump sum damages calculated on the basis of the amount of royalties that would have been due if the infringer had sought an authorisation (licence) from the rightholder. Where a licence royalty is already fixed and used in the relevant sector, this amount will be used; if there is not an agreed royalty rate or where it is difficult to determine precise rates, often an estimated average royalty related to the specific type of business involved is used.

From information received it seems that there are doubts whether the criteria for the calculation of damages (damages appropriate to the actual prejudice suffered by the rightholder and lump sum damages) are **alternative**, and therefore leave a real choice to the judicial authorities, or whether the lump sum damages only come into play if the damage cannot be assessed according to the actual prejudice suffered. It appears that Member States' practice in this respect varies. In some Member States (e.g. Hungary, Latvia, Slovak Republic) it appears that lump sum damages are available *only if* damages cannot be calculated otherwise, for example in cases when the actual prejudice cannot be calculated precisely. In those cases, the amount of the damage is assessed on the basis of the principle of equity. In other Member States (e.g. the Netherlands, Poland), it seems that courts or parties can freely choose according to which criterion they assess the damage.

The wording of the Directive suggests the judicial authorities should be allowed to assess the damage according to the actual prejudice or to award them as a lump sum, as they consider more appropriate. It could also be desirable for the rightholders to be able to opt for one or the other method of calculation, depending on which is for them the most favourable.

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53 E.g. Germany and Italy.
54 E.g. Benelux countries in cases of bad faith.
55 In Hungary, there seems to be an "upper" limit of HUF 1 million (approx. EUR 3,500) for moral damages awards.

2.7.5. More far-reaching national rules

It should be noted that, in respect of specific infringements (mostly infringements of copyright and rights related to copyright), a significant number of Member States[56] appear to have gone beyond the minimum rules set out by the Directive by introducing lump sum damages set as multiple (mostly double) amounts of royalties (licensing fees) due. Furthermore, at least one Member State reports to provide for **punitive damages**.[57]

2.7.6. Legal costs and other expenses

Most Member States did not need to implement this provision specifically as their previous civil procedural laws already covered the Directive's requirements. In principle, the successful party can recover costs of proceedings necessary for the effective protection or enforcement of intellectual property rights. However, the amount to be reimbursed can be reduced or eliminated in cases where the wins are only partial. Moreover, if the costs incurred are disproportionate or unnecessary, the courts can order a partial recovery of the costs.

The costs of litigation concerning intellectual property rights are often very high. This is partly due to the fact that in order to gather proper and reliable evidence, technical expert(s) (e.g. such as patent agents in patent cases or Internet investigator(s)) must be engaged by the rightholders. Moreover, the rightholders must sometimes do 'test purchases' in order to confirm an infringement of their rights or to gather evidence. Translations are often required, too. Furthermore, given the (often) cross-border nature of the infringing activities, experts from several jurisdictions may be required to assist. These costs are not always fully taken into consideration by the courts. In some jurisdictions, only the fees of the experts appointed by the court are reimbursed.

It appears that rightholders rarely are reimbursed all legal costs and other expenses they encounter to protect their rights in the proceedings concerning infringements of intellectual property rights. Stakeholders' consultation revealed the following, very different, experiences with the reimbursement of the legal costs in a successful litigation: 10-50% in Denmark, 'only a small percentage' in Greece, 30% in Italy, 10-30% in Luxembourg, 50% in Cyprus, 66%-100% in Romania, 'very low' in Spain, about 75% in Sweden, 50-70% in Austria, 80% in Ireland. The possibility of a 100% reimbursement was reported for Lithuania, Hungary, Slovakia and Austria for simple cases. Many stakeholders were not able to state the percentage because of inconsistent experience and disparate case-law (e.g. Latvia). One respondent (Slovakia) stated that lawyers' fees are substantially limited when the claims cannot be assessed in monetary terms (e.g. where the rightholder requests termination of the infringing activities).

To summarise, it seems that the reimbursement of legal costs and other expenses in a successful litigation usually remains far below the actual legal costs incurred.

2.8. Codes of Conduct

Article 17 of the Directive obliges the Member States to encourage the development, by trade or professional organisations, of codes of conduct at Union level that are aimed at contributing towards the enforcement of intellectual property rights.

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56 E.g. Austria, Belgium, Czech Republic, Germany, Greece, Lithuania, Poland, Romania and Slovenia.
57 Slovenia.

In several Member States associations have made use of such a collaborative approach and have put in place national codes of conducts (voluntary arrangements) to combat counterfeiting and piracy.[58] In some cases, such voluntary agreements became the basis for legislation.[59] However, in other Member States such arrangements would seem not to be possible, mainly due to the restrictions imposed by privacy laws and protection of personal data, which prevent intermediaries (e.g. Internet service providers) to forward warning notices to the alleged infringers or to share information about the alleged infringer's identity outside the scope of judicial proceedings.

3. ABSENCE OF HARMONIZED PROTECTION OF INTELLECTUAL PROPERTY RIGHTS THROUGH CRIMINAL LAW

Counterfeiting and piracy appears to be increasingly linked to organised crime[60] raising security and safety concerns and is also proven to be spreading over the Internet. Therefore measures taken against cybercrime at EU level should be seen as relevant and complementary to the legislative and non legislative measures taken and to be taken in the civil and criminal area.

Despite the fact that almost all Member States provide for criminal measures to protect intellectual property rights, the disparities between the national definitions of the kind and level of penalties for the various infringements of intellectual property rights may make it difficult to combat these infringements effectively.

The Commission is currently analysing to what extent protection of intellectual property rights through criminal law via a harmonized directive on criminal measures is necessary to supplement the enforcement of intellectual property rights through civil law. Absence of harmonisation in the area of criminal measures to protect intellectual property rights could be a serious obstacle and hinder cross-border cooperation between the law enforcement agencies.

Following this assessment, the Commission intends to present a new legislative proposal which would replace the 2006 proposal for a Directive on criminal sanctions[61].

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[58] In Estonia, it has been reported that a Memorandum of Understanding was signed between Estonian Organisation of Copyright Protection and several internet service providers to enable the removal of material that infringes intellectual property rights. In Denmark, internet service providers together with the Danish IT Industry Association (ITB) and the Telecommunication Industries in Denmark (TI) have agreed to collaborate on combating piracy on the internet and a Code of Conduct for internet service providers concerning the enforcement of intellectual property rights has also been agreed. Similarly in France, the "*Charte de lutte la contrefaçon sur Internet"* was signed between the French online market places and rightholders to advance the fight against the sale of counterfeit goods over the internet.

[59] For example "Élysée agreement for the development and protection of creative works and cultural programmes on the new networks" was a basis of the legislation which was adopted subsequently in France.

[60] See e.g. Europol, 'OCTA 2009 - EU Organised Crime Threat Assessment', http://www.europol.europa.eu/publications/European_Organised_Crime_Threat_Assessment_(OCTA)/OCTA2009.pdf.

[61] Amended proposal for a Directive of the European Parliament and of the Council on criminal measures aimed at ensuring the enforcement of intellectual property rights (COM(2006) 168 final).

4. CONCLUSION

On the basis of the information available at this stage it can be concluded that the Directive has provided a solid basis for the enforcement of intellectual property rights in the internal market and led to considerable improvements of the legal frameworks in place in the Member States.

However, the analysis shows that some of the provisions of the Directive have led to diverging interpretations by the Member States and by the courts, and some of these provisions have not fully reached the objectives pursued by the Directive. At the same time, infringements of intellectual property rights have reached a significant level. The provisions concerned could therefore be clarified. Clarification could also be necessary in order to reinforce the dissuasive effect of the Directive and therefore its effectiveness.

Annex 1: The transposition of the Directive by the Member States and Member States' application reports

1. Transposition process

Few Member States transposed the Enforcement Directive on time, i.e. by 26 April 2006: only 5 Member States (Denmark, Hungary, Italy, Slovenia and the UK) complied with the deadline.

Most of the Member States were late with the implementation. 20 infringements for non-communications were recorded, namely against Austria, Belgium, Cyprus, Czech Republic, Estonia, Finland, France, Germany, Greece, Ireland, Latvia, Lithuania, Luxembourg, Malta, the Netherlands, Poland, Portugal, Slovak Republic, Spain and Sweden. Out of these, 15 cases were closed before reaching the stage of referral to the Court of Justice of the European Union. A referral was made for Germany, Luxembourg, Sweden, France and Portugal.

Subsequently, the case was withdrawn for France and Portugal. The last Member States to implement the Directive were Germany (July 2008), Sweden (April 2009) and Luxembourg (June 2009), after a decision confirming an infringement had been taken by the Court of Justice. Despite of having notified complete transposition, in the course of the works to draw up this report it turned out that Greece seems not to have implemented the Directive it its entirety yet, but only in respect of copyright and related rights.

2. Implementation Reports

Article 18(1) of the Directive obliges Member States to submit, three years after the expiry of the deadline for the transposition, a report to the Commission on the implementation of the Directive.

However, even by autumn 2010, not all national reports have been received by the Commission. Thus, Bulgaria and Spain did not provide any report. Greece provided an incomplete report covering only copyright and rights related to copyright. Some reports have been received by the Commission with a significant delay (e.g. the reports by Belgium and Sweden which were received in May 2010, Luxemburg and Portugal only sent their report in October 2010).

Furthermore, the completeness and the quality of these national reports appear to differ considerably. The late transposition of the Directive was, for some of reports, the main reason for this difference in quality. The most complete reports are reflecting in depth the national situation and contain statistical data including jurisprudence. Some Member States have also provided the Commission with information on stakeholders' perceptions. Such reports have been received by the Commission for example from Denmark, Estonia, Germany, Hungary, Ireland, Latvia, Lithuania, Poland and Slovenia.

From the other, less detailed reports, it was not possible to make a clear assessment of the implications the Directive has had on innovation and the development of the information society. Cyprus, France, Luxembourg, Malta, the Slovak Republic and the UK have provided reports with particularly limited information.

As a result, the Commission has not been able to engage in a critical economic analysis of the effects that this Directive may have had on innovation and the development of the information society.

Annex 2: Methodology for the Analysis

1. Information gathering from the Member States

The Commission's services have carefully examined the national implementation reports provided by the Member States and have integrated information contained in these reports into the text of the Staff Working Paper. Apart from the information contained in these reports, the Commission did not receive a substantial amount of additional information from the Member States' authorities, neither during the implementation period, nor after the transposition of the Directive into the national law. As a result, and because of the reasons mentioned above, the information received had to be complemented from other sources, in particular through consultation with rightholders, and in particular through the consultation of legal experts from the private sector who meet regularly in the legal subgroup that has been formed in the context of the European Observatory on Counterfeiting and Piracy.

2. Information gathering from the stakeholders

The legal subgroup formed in the context of the European Observatory on Counterfeiting and Piracy made an attempt to screen the implementation and the application of the Directive in all 27 Member States. It concentrated on the national legislation as well as the national court practices. The work was divided into several sections: damages and legal costs, corrective measures, evidence and right of information and injunctions, where four detailed questionnaires have been produced by the subgroup together with the Commission services. These questionnaires were subsequently forwarded to rightholders and legal practitioners in all Member States. Detailed responses are available at the website of the European Commission.[62] The summaries of the responses also contain some conclusions and practical recommendations for improvement.

A substantial amount of information was gathered through bilateral contacts and consultation papers issued by the business associations. Commission services have also held a number of meetings with private sector stakeholders and with individual companies (in particular rightholders and intermediaries) on the operation of the Directive.

[62] http://ec.europa.eu/internal_market/iprenforcement/observatory/index_en.htm



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